



Intellectual Property Rights in the International Growth of SMEs

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Nice to meet you

A few words about me...



Maciej Majewski, attorney-at-law



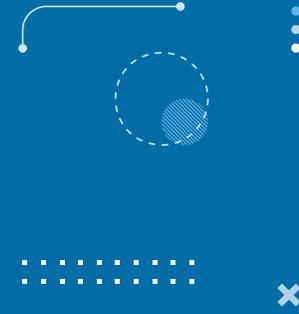
- For about 8 years now, I have worked as a lawyer at Traple Konarski Podrecki & Partners.
- My law firm specialises in all things IP. We work closely with businesses, including SMEs, on all kinds of projects: from drafting opinions and memos, through negotiating and drafting contracts, to representation before administrative bodies and in court proceedings.
- My other areas of expertise include competition and consumer protection law and civil law.
- Especially passionate about the video games industry.



Part I

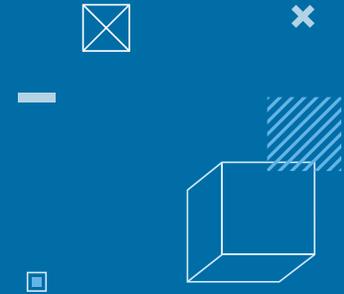
Introduction to intellectual property law





Intangible goods

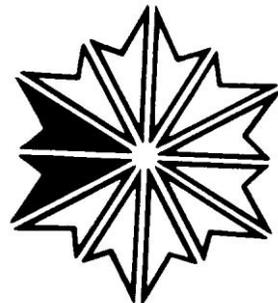
What do intellectual property rights actually protect?



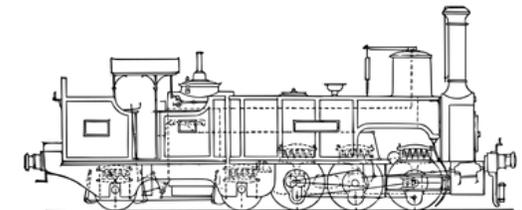
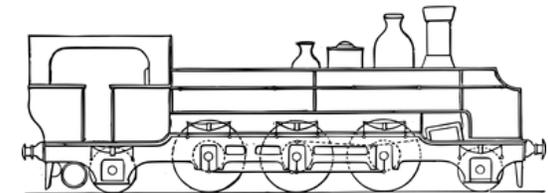
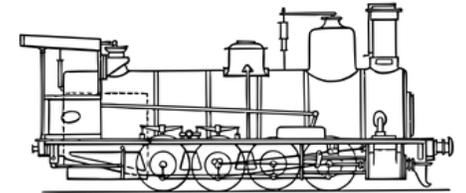
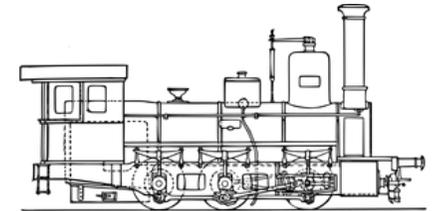
Intangible goods



- What is an „intangible” good?
 - something immaterial?
 - something that does not derive value from its physical attributes/properties
 - an idea?
 - trade secret/know-how (data, information), an invention, a word trademark
 - an expression of an idea?
 - a work (painting), a figurative trademark



McDONALD'S



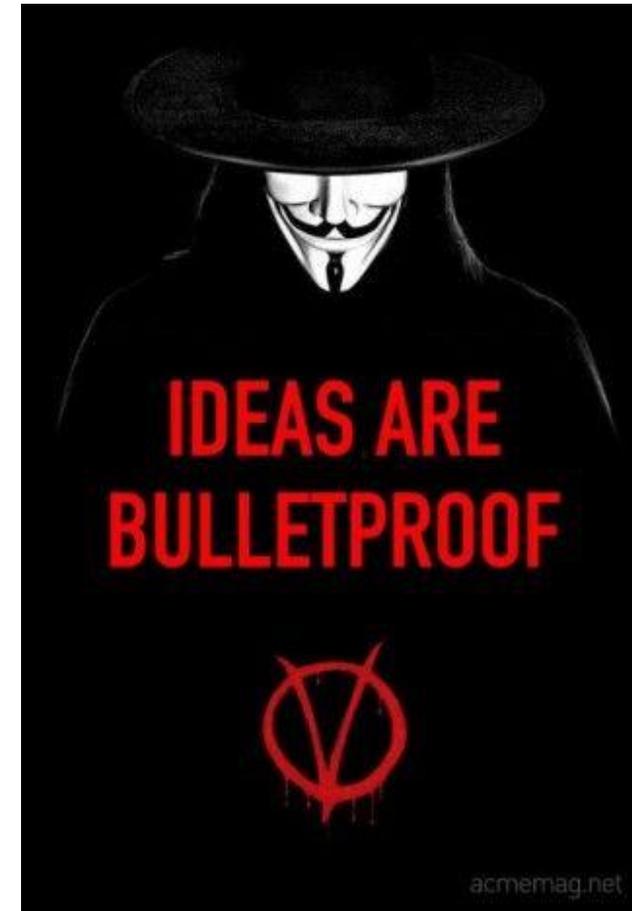
Intangible goods

- Is it common to seek protection? Is it necessary? Useful? What are the benefits? Is it just a precaution? Can I wait with taking any actions? Is protection costly? Should I wait until I have a concrete, definite need or problem?

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Intangible goods

- Key characteristics:
 - they can be perceived without having to interact with a physical object (although the object may be needed to get to know them, use them etc.),
 - they can be simultaneously perceived, accessed, used etc. by an unlimited number of people (one person's actions cannot typically „deprive” someone else of the possibility to interact with an intangible good)
 - they can't be destroyed(?)



Intangible goods

These key characteristics lead to the key „feature” of intangible goods...

**They can potentially be
very quickly reproduced
and/or very easily available!**

**As such, they become
difficult to „control”.**



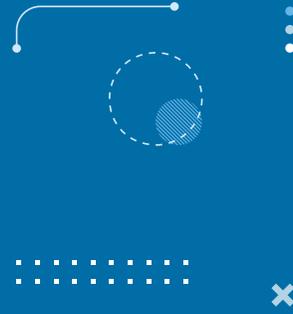
Intangible goods – key takeaways

- Intangible goods can vary in nature, type etc.
- Intangible goods can be valuable because of many different reasons
- There is no finite number or list of intangible goods (we may create new ones, not all are currently being protected by IP law)
- There are no effective factual measures to prevent others from benefitting from intangible goods of our creation and that's why we need legal protection, assurances and so on...

(although...)

Beginnings of intellectual property

How did it all start?



Beginnings of intellectual property rights

- It is universally agreed that IP protection schemes take their roots in regulations of 17th and 18th century England. Earlier any protection of this sort has been granted only on individual bases as the ruler saw fit.
- 1624 – the Statute of Monopolies
(regulated patents, annulled all earlier rights, provided for the possibility to issue „letter patents” and „grants of privilege” for 14 years)
- 1710 – the Statute of Anne
(regulated copyright, mainly focused on commercial aspects and publishers, declared to be issued in the interest of authors who also gained certain rights)

Beginnings of intellectual property rights

- Building the foundations for international IP regime
(necessary to allow any form of effective trade and exchange of technology between the countries and put an end to free riding – entrepreneurs refused to share their ideas and knowledge due to fear of being „robbed”)
- 1883 – Paris Convention
- 1886 – Berne Convention
- 1891 – Madrid Agreement

Beginnings of intellectual property rights

- Establishing the World Intellectual Property Office (1970)
 - beginning of a „new era”



- Agreement on Trade-Related Aspects of Intellectual Property (1994)
 - the hallmark international document regarding IP rights



Beginnings of intellectual property rights – key takeaways

- Most intellectual property regimes have common roots and are based on internationally acknowledged standards
- However, many multilateral treaties or conventions remain non-specific when it comes to certain issues – when no agreement could be reached between the contracting parties, the problem was left unmentioned or left expressly up to national lawmakers to regulate.
- When it comes to IP law, especially in the international context, precision and thorough checks are crucial to avoid legal risks.

Types of intellectual property and benefits of legal protection

How can we benefit from IP rights?



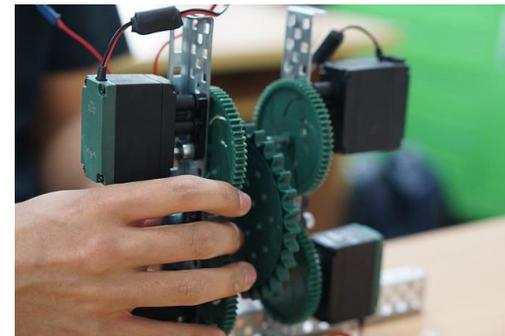
Types of intellectual property and benefits of legal protection

- IP law is very often presented as having been designed to protect creators – to compensate them for their work, skills, efforts, time etc. (creators are naturally „entitled” to profit from their creations)



Types of intellectual property and benefits of legal protection

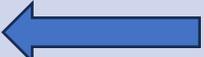
- In fact, intellectual property law as a whole was designed to remunerate the creators for... their input to improving the society's overall welfare! As such, law provides legal instruments to protect creators only if their creations match certain criteria set forth by the lawmaker.
- Scope, instruments, methods and reach of protection may differ depending on what exactly type of good is being protected.



Types of intellectual property and benefits of legal protection

- Intellectual property encompasses different types of rights and/or privileges (and different types of restrictions on protection!)
- Next slides present a brief overlook of the characteristics of the most common IP rights as well as the objects of legal protection
- Remember – to get ahead you have to be aware of opportunities that IP law gives you as well as associated risks which may impede your growth, result in free riding or require you to engage in litigation

Types of intellectual property and benefits of legal protection

Copyright (70 years after author's passing)	Related rights (may differ for particular types of goods)
Protection applies automatically from the moment the „work” is <u>established</u>	 (<i>although...</i>)
Protection is free (<i>although...</i>)	
<ul style="list-style-type: none"> • Copyright protects a <u>work</u> i.e. a concrete <u>expression</u> of a given idea (e.g. a specific painting showing a castle). Copyright applies to any kind of work imaginable (movies, photos, choreography, tattoos). • Ideas, rules and methods are not themselves copyrightable (e.g. an idea of a school for wizards). 	<ul style="list-style-type: none"> • Related rights protect <u>efforts and investment related to the creative proces behind works</u> (artistic performance, phonograms, videograms, broadcasts, first publication, critical publication...) • Some of them can apply to the same „object” simultaneously (apart from copyright itself).

Types of intellectual property and benefits of legal protection

Moral author's rights (unlimited term)	Trademarks (10 years; virtually unlimited)
Protection applies automatically from the moment the „work” is <u>established (fixed)</u>	Protection requires <u>registration</u> (<i>although...</i>)
Protection is free (<i>although...</i>)	Protection requires payments
<ul style="list-style-type: none"> • Protect the <u>emotional link</u> between a work and its creator (authorship, integrity of the work, first decision on making the work publicly available, supervision of how the work is used...) • Not universally acknowledged • Typically cannot be sold or waived 	<ul style="list-style-type: none"> • Trademarks protect predominantly the <u>association (ties)</u> between a characteristic word, image, sound, shape, movement, colour or other identifying feature of a product (a <u>mark</u>) and a certain company • Trademarks do not grant an absolute control over the distribution of products (<i>although...</i>)

Types of intellectual property and benefits of legal protection

Database protection (15 years; can be partially renewed)	Patents (20 years; can be extended)
Protection applies automatically from the moment the database is <u>established (fixed)</u>	Protection requires <u>registration</u>
Protection is free (<i>although...</i>)	Protection requires payments
<ul style="list-style-type: none"> • Protects <u>substantial investment</u> in creating a <u>database</u>, that is in gathering, verifying and presenting the data (not creating the data itself) • Not universally acknowledged (<i>although...</i>) 	<ul style="list-style-type: none"> • Patents are granted for <u>inventions</u> of any kind that are useful, new (non-obvious) and can be applied in industrial use. • They can protect ideas, methods, substances or their use...

Types of intellectual property and benefits of legal protection

Utility models (10 years)	Industrial designs (25 years)
Protection requires <u>registration</u>	Protection requires <u>registration</u> but there are <u>exceptions</u>
Protection requires payments	←
<ul style="list-style-type: none"> • Protect <u>technical solutions</u> that are new and useful and enable the achievement of an objective of practical importance. • Not universally acknowledged 	<ul style="list-style-type: none"> • Protect <u>new appearance</u> of a product (or its part) which is of individual character and results from product's features or ornamentation.

Types of intellectual property and benefits of legal protection

- Specificity of some industrial property rights (a „sub-category” of IP)

Once a good has been created, a so-called "right to apply" for the industrial property right is awarded.

Application to the appropriate office begins the process of acquiring the actual right (the procedure may slightly re-shape the right granted).

After the grant of protection and making a payment, the right becomes effective in the office's territory and is entered into a register.

Types of intellectual property and benefits of legal protection

- In all cases of IP rights, the fundamental thing to remember is that no IP laws will do us any good if we do not effectively secure respective rights!
- That is why the first order of business when updating your IP policies, strategies and goals needs to be to **verify, audit and – where necessary – adjust all the contracts based on which you acquire rights to certain intangible goods**. Be it employment contracts, work for hire, B2B contracts or any other form of cooperation or transfer of rights.
- The audit shall include i.a.: the form of the contract, scope of the contract, provisions on the transfer of rights (especially in the context of mandatory statutory provisions), consequences of termination etc.

Types of intellectual property and benefits of legal protection

- Typically transfer of rights requires a written form of an agreement (in case of IP rights which are disclosed in a public register, it may be necessary or highly desirable to inform respective authority and initiate an update of the information of the rightholder/licensee etc.)
- Most common omissions in this regard include:
 - imprecise clauses in employment contracts;
 - no update of the employment agreement after the scope of work carried out by the employee has changed;
 - mechanically copy/pasted provisions which may be inaccurate or unsuitable.

Types of intellectual property and benefits of legal protection

- Remember(!)
- Regulations concerning different IP rights may contain unique provisions regarding especially the transfer of rights from an employee to the employer and further legal consequences thereof.

Types of intellectual property and benefits of legal protection – key takeaways

- Intellectual property law protects different types of intangible goods – the scope and terms of such protection depend on a few factors:
 - what exactly the lawmaker wanted to shield from detrimental actions of third parties (especially by granting exclusive permission to use and benefit from certain creations of human intellect)
 - what characteristics a given category of goods possesses
- Certain goods may incorporate more than one intangible good and as such benefit (suffer?) from overlapping protection rights (!)

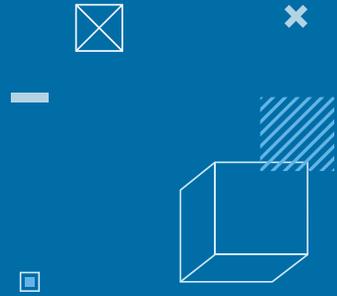
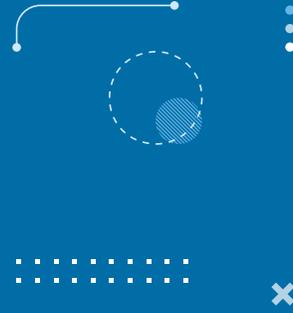
Types of intellectual property and benefits of legal protection – key takeaways

How much IP is there in a cup of tea?

- Trade marks**
Protect tea brands
- Trade secrets**
Protect tea recipes that include secret ingredients
- Patents**
Protect the method for brewing, storing or dispensing tea
- Design rights**
Protect the look & feel of tea-makers, teapots or tea bags
- Geographical Indications**
Protect the distinctive flavour and quality of a tea linked to its geographical origin

Part II

Intellectual property rights in the context of international trade



Territoriality of intellectual property rights

Basic principles



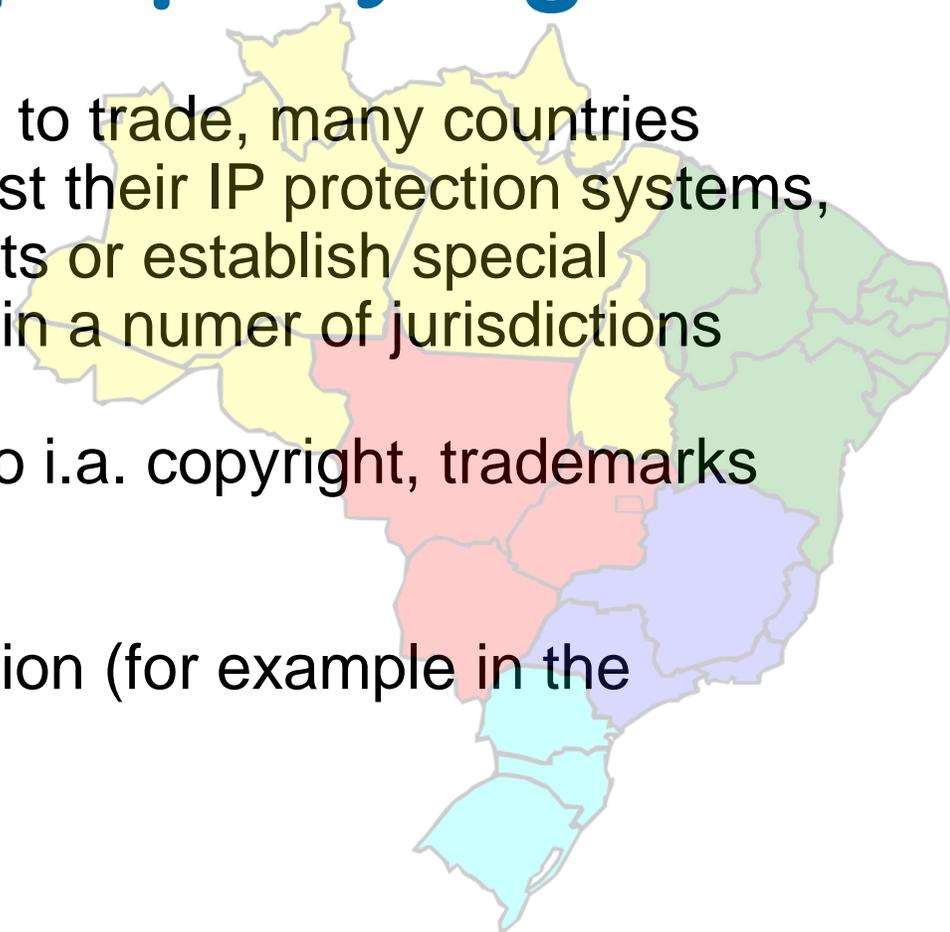
Territoriality of intellectual property rights

- There is a tendency to talk about IP rights as though they apply everywhere in a uniform and coherent fashion
- That is NOT the case!
- IP rights are typically granted by individual lawmakers and as such each intangible good is protected by separate regulations from each individual jurisdiction (of course some exceptions exist)



Territoriality of intellectual property rights

- In order to remove, as much as possible, barriers to trade, many countries have entered into multilateral agreements to adjust their IP protection systems, set uniform or similar standards for exclusive rights or establish special procedures to facilitate simultaneous registration in a number of jurisdictions
- Such international treaties or conventions apply to i.a. copyright, trademarks and patents
- There are also some regional schemes of protection (for example in the Benelux region or within the European Union)



International intellectual property rights protection systems

Where do we stand now?



International intellectual property rights protection systems

- Berne Convention (WIPO administered)
 - scope: copyright and author's moral rights
(it is up to the contracting parties to regulate the means of redress and the extent of protection not covered by the treaty; conventions covers i.a.the term of protection [50 years] and exclusive rights of reproduction, public performance and communication to the public)
<https://www.wipo.int/wipolex/en/text/283693>
 - contracting parties
(careful – certain countries may be bound by different texts)
<https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/berne.pdf>

International intellectual property rights protection systems

- Paris Convention (WIPO administered)
 - scope: industrial property rights
(regulates i.a. the issue of „priority” to acquire industrial property rights – after the right has been applied for in one of the contracting states)
<https://www.wipo.int/wipolex/en/text/287556>
 - contracting parties
(careful – certain countries may be bound by different texts)
<https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/paris.pdf>

International intellectual property rights protection systems

- TRIPS Agreement (WTO administered)
 - scope: copyright, trademarks, geographical indications, industrial designs, patents, topographies of integrated circuits, trade secrets
(detailed, comprehensive, mentions the problematic „exhaustion” principle – neutral take on this instrument)
- https://www.wto.org/english/docs_e/legal_e/27-trips.pdf
- contracting parties: all WTO members (164, soon-to-be 165?)

International intellectual property rights protection systems

- Budapest Treaty (WIPO administered)
 - scope: cooperation in patent registration
(regards depositions of microorganisms in offices from contracting parties)
<https://www.wipo.int/wipolex/en/text/283781>
 - contracting parties:
<https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/budapest.pdf>

International intellectual property rights protection systems

- Nairobi Treaty (WIPO administered)
 - scope: cooperation in protection of the Olympic symbol
(regards grounds for refusal to register as a trademark and prohibition of use in commerce)
<https://www.wipo.int/wipolex/en/text/287413>
 - contracting parties:
<https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/nairobi.pdf>

International intellectual property rights protection systems

- Hague Treaty (WIPO administered)

- scope: cooperation in protection of industrial designs
(regards a simultaneous application to different countries)

<https://www.wipo.int/wipolex/en/text/287413>

- contracting parties:

<https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/nairobi.pdf>

International intellectual property rights protection systems

- Patent Cooperation Treaty (WIPO administered)
 - scope: cooperation in protection of inventions
(regards the possibility to apply through WIPO for patents in contracting countries)
<https://www.wipo.int/wipolex/en/text/288637>
 - contracting parties:
<https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/pct.pdf>

International intellectual property rights protection systems

- Madrid Protocol (WIPO administered)
 - scope: cooperation in protection of trademarks
(regards the possibility to obtain an international registration)
<https://www.wipo.int/wipolex/en/text/283483>
 - contracting parties:
https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/madrid_marks.pdf

International intellectual property rights protection systems

- Treaties regarding facilitation of comparison and verification of application for industrial property rights, establishing certain classifications:
 - Nice Classification – classifies goods and services for trademark registration purposes
 - Vienna Classification – classifies figurative elements for trademark registration purposes
 - Locarno Classification – classifies goods for industrial design registration purposes
 - Strasbourg Classification – classifies sections/divisions of technology for patent registration purposes

International intellectual property rights protection systems

...AND MANY MORE!

International intellectual property rights protection systems

- Some countries have decided to not only set uniform standards for IP protection but also to create separate, unitary rights that would be in effect and enforceable in the territory of all contracting states.
- The European Union is the pioneer in this regard, having created e.g. the Community Design right (soon-to-be European Design) and the EU trademark right.
- EU rights can be registered in the European Union Intellectual Property Office (EUIPO).



International intellectual property rights protection systems

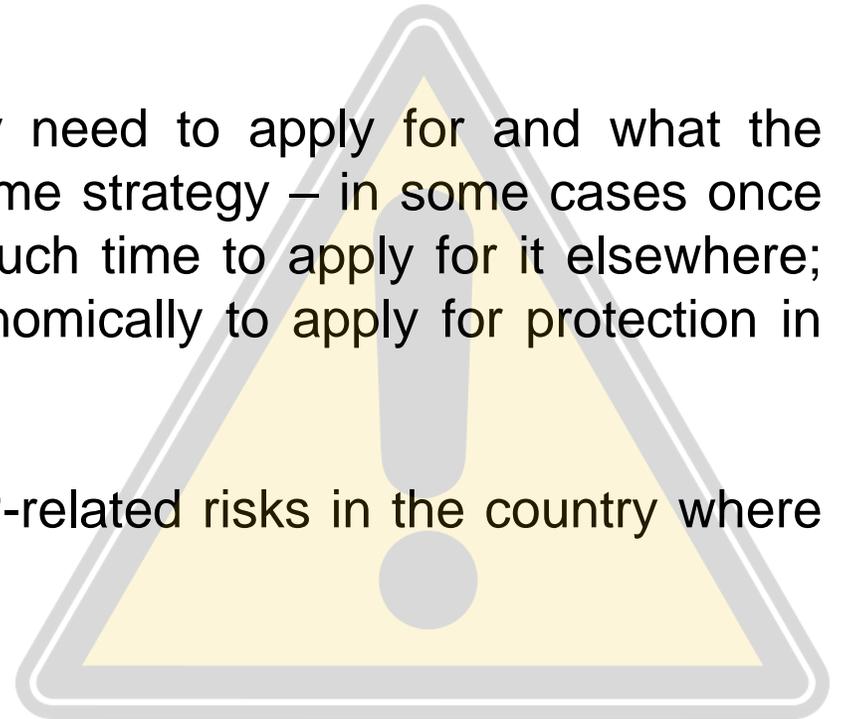
- Other tools – EU has made great progress in harmonising IP law across member states through the use of directives. Directives require countries to implement certain rules and instruments into national legislature.

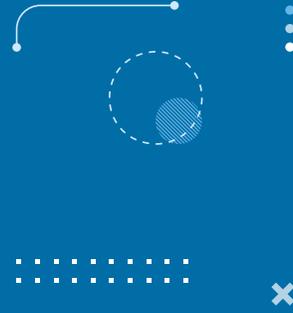
Careful! *Even with such instruments a number of issues remain distinct between jurisdictions. **Example:** the freedom of panorama copyright exception.*

- Convergence – where possible, national offices and courts aim to interpret and invoke law in a manner consistent with that of EU institutions (harmonised practice). Authorities exchange information, knowledge and experience.

International intellectual property rights protection systems – key takeaways

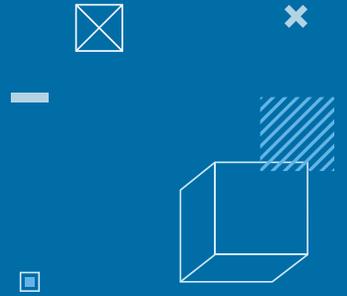
- If you ever wish to expand your business to other territories pay very special attention to intellectual property issues
- Make sure to pre-emptively identify what rights you may need to apply for and what the probability of success is (consider this even in your long-time strategy – in some cases once you apply for a right in one country, you only have that much time to apply for it elsewhere; sometimes it may even be necessary or more viable economically to apply for protection in different countries simultaneously)
- Make sure that your business model does not pose any IP-related risks in the country where you wish to expand to





Barriers to trade

Can IP impede international growth?



Barriers to trade

- Territoriality of IP rights may stand at odds with free movement of goods – it may be unclear whether a trader can import or export certain products
- „Exhaustion” or the „first sale” doctrine is aimed at balancing the interests of the rightholder and owner of the physical medium in which the intangible good is incorporated
- Provides for the right of a legitimate owner to further distribute and/or dispose of the good as they see fit
- Condition: the physical medium had to have been put on the market by the rightholder or with his consent (by a third party)

Barriers to trade

- Problematic issue: should sale in a different country result in exhaustion in a given jurisdiction?
- Example: an author of a book signs a publishing deal with a company from the US. The publisher sells the books to a distributor who then sells some of them to book stores and some of them to another distributor who chooses to export the books to EU and sell them there. Is he allowed to?
- Many jurisdictions differ in their approach to the exhaustion doctrine. What is more, this approach keeps on evolving...

Barriers to trade

- Potential ways to address this issue:
 - allow further sale after first sale has taken place irrespective of where that was
(*the principle of „world exhaustion” -> e.g. adopted by the U.S. in copyright law*)
 - allow further sale after first sale has taken place in selected jurisdictions
(*the principle of „regional exhaustion” -> e.g. adopted by the EU in respect of all categories of IP rights*)
 - allow further sale after first sale has taken place in that particular country
(*the principle of „national exhaustion” -> e.g. in force in the U.S. in copyright law before a precedent ruling adopted world exhaustion*)

Barriers to trade

- **Caution!**
- Certain countries apply different principles of exhaustion to different IP rights.
- Some objects are simultaneously protected by numerous rights -> one has to verify if exhaustion applies to all of them (this is sometimes abused by entrepreneurs who compliment products with features that can exclude full exhaustion).
- Special conditions or possibilities regarding exhaustion may exist in some sectors or fields (e.g. computer programmes, pharmaceuticals)

Barriers to trade

- **Caution!**
- For exhaustion to apply there needs to be **identity** between the rightholder in the country of first sale and the country where exhaustion takes effect!

Example: the brand „Persil” belongs to different entities in different countries



<- „Persil” trademark
owned by Unilever
e.g. in the UK

Persil

<- „Persil” trademark
owned by Henkel
e.g. in Poland

Barriers to trade

- **Caution!**
- Due to their territoriality, IP rights can be tempting as a means to partition/divide the market, especially in order to limit the supply and increase prices.
- When coming up with business strategies or drafting licensing agreements always keep in mind that even though something may be possible under IP law, it may well be prohibited under other regulations, such as for example applicable competition protection law
(*crucial consideration in the EU internal market...*)



Barriers to trade

- CJEU judgement of 27 September 2023 in the T-172/21 case
- *„...it is settled case-law that the mere fact that an agreement involves intellectual property rights does not preclude the application of Article 101 TFEU. Although the Treaty does not affect the existence of intellectual property rights, in particular copyright, the exercise of those rights may nevertheless fall within the prohibitions laid down by the Treaty (...). (...) the fact that the copyright holder may continue to exercise his or her rights (...), does not preclude such an exercise of copyright from being caught by Article 101 TFEU, where that exercise could constitute a disguised restriction on trade between Member States (...).”*

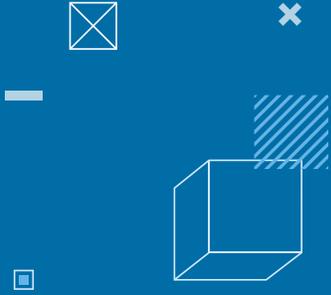
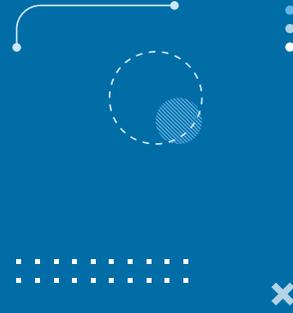


Barriers to trade – key takeaways

- Depending on your role on the market, IP regulations may impact your business in different ways
- The same is true for the territory you wish to be active in
- Always keep in mind that technical conformity with IP regulations does not exempt you or your market behaviour from observing other possible applicable rules

Part III

Copyright and related rights



Copyright

Protection on the condition of establishment of a work

- Copyright protection is enjoyed by „works”
- A work is defined as **result of creative activity that shows individual character**
- The condition of protection is that a work is **established** in any form (does not have to be „fixed” that is recorded or otherwise preserved – although it may be very helpful if we want to later restore the original form, depending of course on the type of work in question)
- Computer programmes, collections, anthologies, selections, databases are subject to protection provided they have features of creativity.

Copyright

- Copyright applies independantly to so-called derivative works that is works which include/incorporate the creative elements from already existing works (examples include translation, movie or game adaptation and so on).
- In the EU protection applies automatically without the need to register the work, make a copyright note on a copy of the work
- The period of protection of economic copyrights is 70 years and starts running as of: as a rule, the date of the author's death, and in case of collective works – 70 years from the date of death of the last surviving author. After expiry of the protection period a work enters the public domain.

Lack of copyright protection



An idea



Individuality, creative character cannot be attributed to a single colour as well as the juxtaposition of several colours. It is therefore not possible to obtain copyright protection for the juxtaposition of several colours.



A simple graphic design that lacks individuality and creativity
(arrows,)

Copyright – summary of basic info



separation of the work from
the physical copy



work has been
established



assessment of whether or
not we are dealing with a
work is not always obvious
(liberal approach dominates)



copyright is typically used to
refer to economic rights but
can also encompass
author's moral rights

Copyright

- Due to liberal interpretation of the „creative activity” and „individual character” copyright applies to virtually everything –
- Type of work may impact the degree of originality that a work needs to show but this does not itself prevent such objects as kitchen utensils, pieces of furniture, basic advertising materials or standard software to benefit from protection (decided on a case by case basis).

Copyright – characteristics

- Although we use the singular term „copyright”, there is actually a number of rights that together form the economic rights of the author
- You may already be familiar with such terms as „distribution right”, „right of reproduction” or „right of communication to the public”. These are all different types



Copyright – characteristics

- Each economic right may be transferred or licensed separately(!)
- In Poland regulations provide that for each economic right that is the subject of a contract, the author is entitled to separate remuneration (unless otherwise agreed by the parties)
- The author may also demand that their remuneration is adjusted, shall the buyer or licensee generate revenue based on the rights that is grossly disproportionate from the remuneration that was paid (best-seller clause).

Copyright – secure the rights

- Copyright acquisition can easily be qualified as the most troublesome among all IP rights.
- This is the direct consequence of the „plurality” of economic rights. Many statutes, like the Polish one, require that the contract regarding copyright explicitly names all the so-called „fields of exploitation”.
- **Careful!** In case of certain works (like for example computer programmes), the fields of exploitation can partially differ.

Copyright – author’s moral rights

- Not universally adopted
- Include the rights to:
 - authorship of the work;
 - sign the work with the author’s name or pseudonym, or to make it available to the public anonymously;
 - have the contents and form of the author’s work inviolable and properly used;
 - decide about making the work available to the public for the first time;
 - control the manner of using the work.

Copyright – exceptions

- Two systems in place
- Individual exemptions from copyright (e.g. citation, parody, private use, use for teaching purposes, public exhibition)
- The „fair use clause” approach (takes into account all applicable circumstances)

Related rights

- artistic performance (economic and moral rights)
- phonograms
- videograms,
- broadcasts,
- first publication,
- critical publication



Copyright and related right – key takeaways

- Whatever your business entails, you can be sure it produces many works subject to copyright on a daily basis
- Most of the time, copyrighted works are subject to some other type of IP right from the „related rights” category.
- Copyright is the safest, easiest and likely the cheapest instrument to use in order to secure your interests (as long as you made sure to acquire it). It can be called the „first line of defense” in legal disputes on IP grounds (e.g. it can help you in trademark registration or invalidation proceedings).



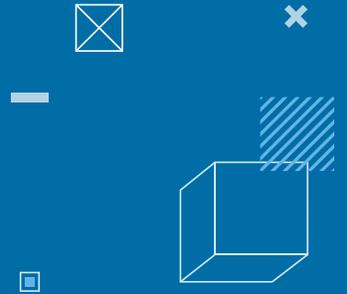
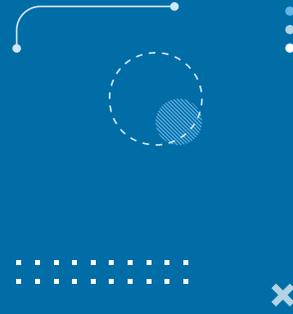
Part IV

Trademarks



Trademarks

Purpose and functions



Trademarks – purpose and functions

- A trademark may consist of any sign provided that such sign is capable of:
 - **distinguishing** the goods or services of one undertaking from those of other undertakings; and
 - being represented in the trademarks register in a manner which enables to determine the **clear and precise** subject matter of the protection afforded to its proprietor (it has to be comprehensible and possible to recreate).
- The following signs may in particular constitute a trademark: words, including personal names, designs, letters, numerals, colours, the shape of goods or of the packaging of goods, sounds.



Trademarks examples

Word mark	Figurative mark	Word – figurative mark	Shape mark
Position mark	Design/Pattern	Colour mark/ combination mark	Hologram mark
Sound mark	Motion mark	Multimedia mark	Others

Trademarks – purpose and functions

- Filing for a trademark



Trademarks – purpose and functions

- **Step 1** – application
- Principle of **specialization** – protection for a particular trademark is granted only to selected products or services, namely those for which the trademark was registered.
- The nice classification is a standardised list of classes of goods and services in which one can apply for a trade mark (classes 1-45). It serves as a helpful instrument but it is not mandatory to use its terms.

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R.349829



Class 30: Confectionery; Gingerbread; Pastry

Trademarks – purpose and functions

- **Step 2** – disclosure
- The fact that the application was made is disclosed so that:
 - it becomes a matter of public record that an application for that specific trademark has already been made;
 - an interested party may inform the office of potential „absolute grounds” for refusal

Trademarks – purpose and functions

- **Step 3** – examination of absolute grounds for refusal
- The office considers whether all formal requirements were met and whether any absolute grounds of refusal can be identified
 - after the office's examination the scope of application may change
 - this can affect the next steps of the procedure (e.g. after the application has been changed there may be no more need to file an opposition based on relative grounds for refusal)

Trademarks – purpose and functions

- **Step 3** – examination of absolute grounds for refusal (EU)

incorrect sign	devoid of distinctive character	descriptive	generic	sign is dictated by the product's nature, technical reasons or gives substantial value to the product
contrary to public policy/morality	deceitful	unauthorised by competent authorities	include badges, emblems etc. of particular public interest	excluded from registration as designations of origin/geographical indications
excluded from registration as traditional terms for wine		excluded from registration as traditional specialities guaranteed		include an earlier plant variety denomination

Trademarks – purpose and functions

- **The most common reasons for refusing the grant of protection include:**
 - using generic or descriptive markings, which consist only of elements that can be used in trade to indicate, in particular, the type of goods, its origin, quality, quantity, value, purpose, method of production, composition, function or usefulness.
Example: an entrepreneur selling milk cannot register a word mark consisting only of the word "milk" or of the words "good milk", because such a mark would only indicate the type and quality of the goods, without identifying the commercial source of these goods (from a specific entrepreneur)
 - application for protection of signs that have entered the colloquial language or are customarily used in fair and well-established commercial practices
Example: nylon, frappe

Absolute grounds of refusal



The word 'extra' is an adjective in the nature of praising goods. The styling of the inscription is simple and the graphic element in the form of a coloured circle is merely decorative. [TSUE judgment of 24 June 2015, T-552/14, cl. 3, 21].



A mere decorative element in the form of a suitcase is not only incapable of diminishing the descriptive message of the sign, but even enhances it. [TSUE judgment of 9 November 2016, T-290/15, cl. 35, 38, 39, 42].

Bioknowledge

Merging words consists in simply combining them into a single word, without giving them any unusual graphical or semantic form by which they could acquire distinctive character in relation to the goods which they are intended to designate. [Judgment of the CFI of 19 January 2005, T-387/03, cl. 9, 16, 42].

Not distinctive

A consumer would not see this bottle, as presented here, as a distinctive sign capable of distinguishing one company from another. This sign should remain available for all companies.

Too descriptive

In this case, consumers will not see the bottle as distinctive, and the word 'wine' simply describes the content of the bottle. They will see it as a product description.



Registrable trade mark

However, in this example, although the bottle alone may not be distinctive, the addition on the label of a distinctive name would make consumers see it as a trade mark indicating one particular brand.

Absolute grounds of refusal

- **The most common reasons for refusing the grant of protection include:**
 - application for a trademark which may, by its nature, mislead recipients, in particular as to the nature, quality or geographical origin of the goods
Example: A figurative word mark was submitted, which is a label with the words "KAMILA cooking oil". The list of goods of this mark includes goods such as fruit juices (and not cooking oil). In such a case, we consider that the mark is confusing for the consumer, as he will expect that the label is labeled with cooking oils and not fruit juices
 - contains the symbol of the Republic of Poland (emblem, colors or anthem), and the applicant has not submitted the consent of the competent state authority
Example: an entrepreneur uses the heraldic image of the Polish coat of arms in a trademark

Trademarks – purpose and functions

- **Step 3** – examination of absolute grounds for refusal (EU)

- Exceptions!

devoid of distinctive character	do not apply if the trademark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it
descriptive	
generic	

Trademarks – purpose and functions

- **Step 4** – publication
- The application is made publicly available so that:
 - an interested party – a proprietor of an earlier trademark – may file an opposition (currently 3 months in EUIPO and at the PPO; this may differ between jurisdictions) and cite relative grounds for refusal:
 - the mark is identical with the earlier trademark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trademark is protected
 - the mark, because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trademark is protected; the likelihood of confusion includes the likelihood of association with the earlier trademark.

Trademarks – purpose and functions

- Additional ground for refusal: collision with a trademark that has „reputation” and where the use without due cause of the trademark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.
- The Court defined the nature of „reputation” by reference to the purpose of the relevant provisions. (...) the Court held that the text (...) **‘implies a certain degree of knowledge of the earlier trademark among the public’** and explained that it *„is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trademark, may possibly make an association between the two trademarks ... and that the earlier mark may consequently be damaged”* (CJEU, case C-375/97).

Trademarks – purpose and functions

- Examples of trademarks with reputation include:
- McDONALD'S (EUTM 000062497 – word mark)

- (EUTM 003021086 – word-figurative mark)



- (R.064281 – word-figurative mark).





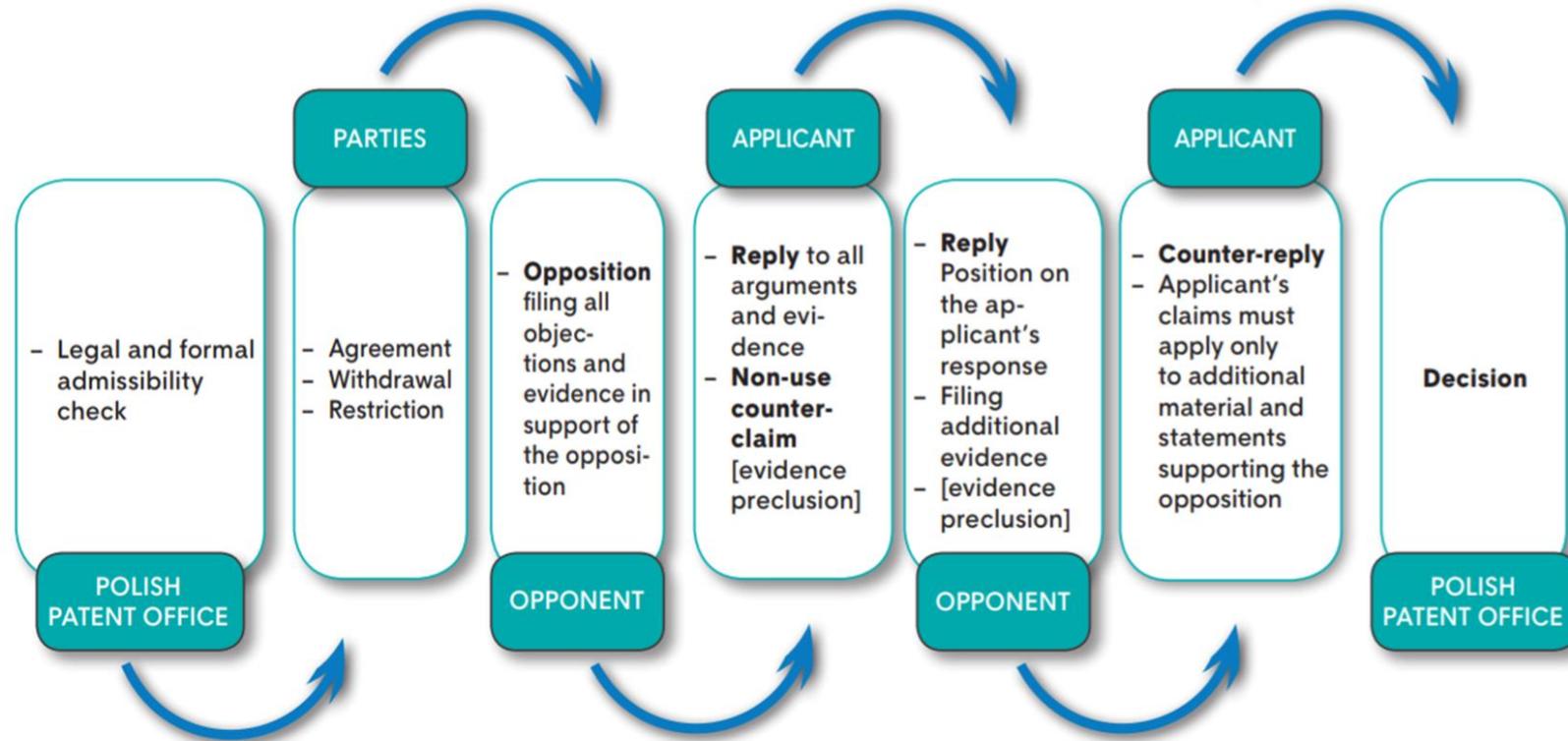
<https://imgur.com/rjRWS>



<https://hunewsservice.com/top-stories/jack-daniels-smells-a-trademark-violation-in-replica-dog-toy/>

Trademarks – purpose and functions

- **Step 5** – opposition proceedings (*if applicable*)



Trademarks – purpose and functions

- **Steps to take BEFORE(!) filing an application**

Before starting the application procedure, it is a good idea to do a preliminary „registration test” (clearance check) – this allows you to assess whether the trademark is likely to be registered, including verification if it contains descriptive or prohibited elements, infringes on earlier marks etc.

The following databases can be searched when identifying and/or analysing the marks of third parties:

- e-Finder (PUEUP) – possibility to check Polish marks
- TMview – data from all EU national IP offices, EUIPO and several non-EU offices (e.g. China)
- Madrid Monitor (WIPO) – possibility to check international marks registered in the WIPO system
- eSearch plus (EUIPO) – possibility to check EU marks
- Global Brand Database (WIPO) – data from all national intellectual property offices in the EU, EUIPO and several non-EU offices

Trademarks

Trademarks types



Trademarks - types

- Word marks

ADIDAS

ZTUE 002288355

PHILIPS

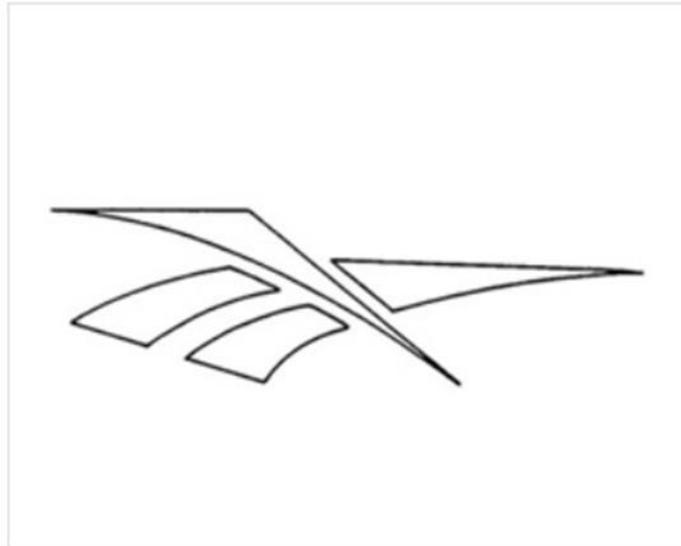
ZTUE 000205971

LEVI'S

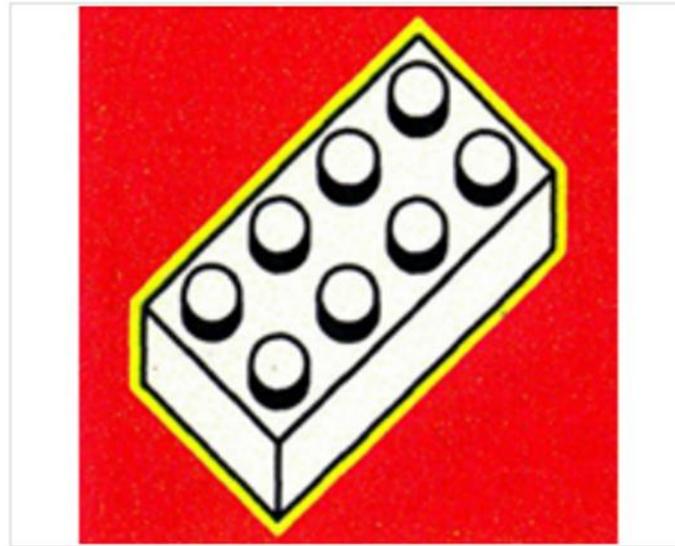
ZTUE 000033159

Trademarks - types

- Figurative marks



ZTUE 000000456



ZTUE 000106948



ZTUE 005271598

Trademarks - types

- Word-figurative marks



ZTUE 009687336



ZTUE 002009298



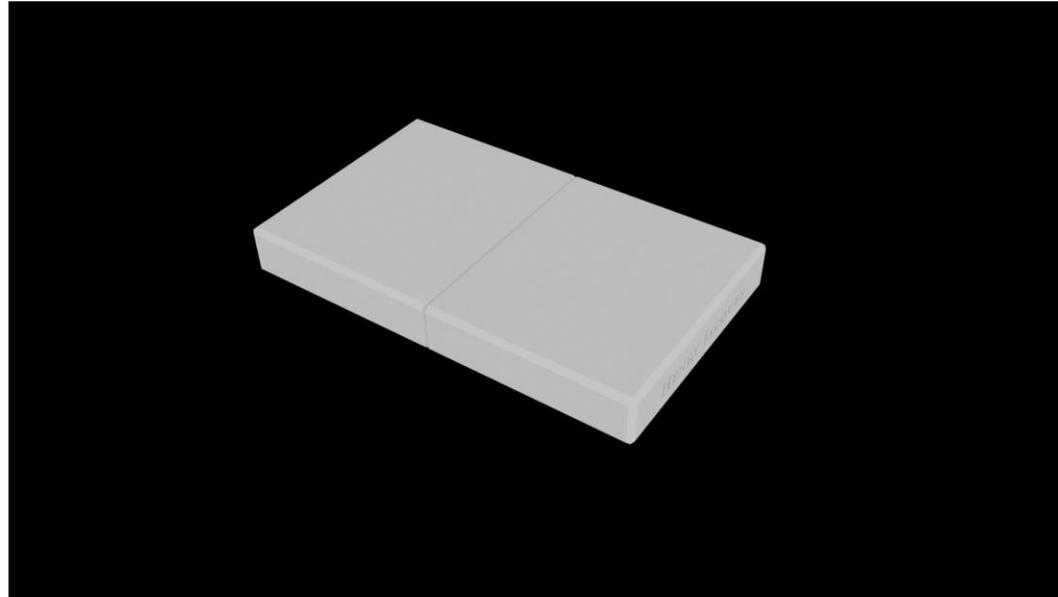
ZTUE 011029477

Trademarks – types

- Traditional marks are usually spoken of in the context of the **graphical representation requirement**. According to that requirement, it must be possible to present the trademark, for which one applies, in graphic form – in an intelligible and clear manner, such as transcription or a sketch.
- The above condition has not prevented traders from seeking to register trademarks other than word or figurative ones.
- Unconventional trademarks first emerged when registration was sought for:
 - 3D shape marks,
 - motion marks (a series of images),
 - sound marks (musical notation),
 - colors alone or a combination thereof.

Trademarks - types

- Motion marks



EUTM 018573663, CREATIONS HENRY JACQUES

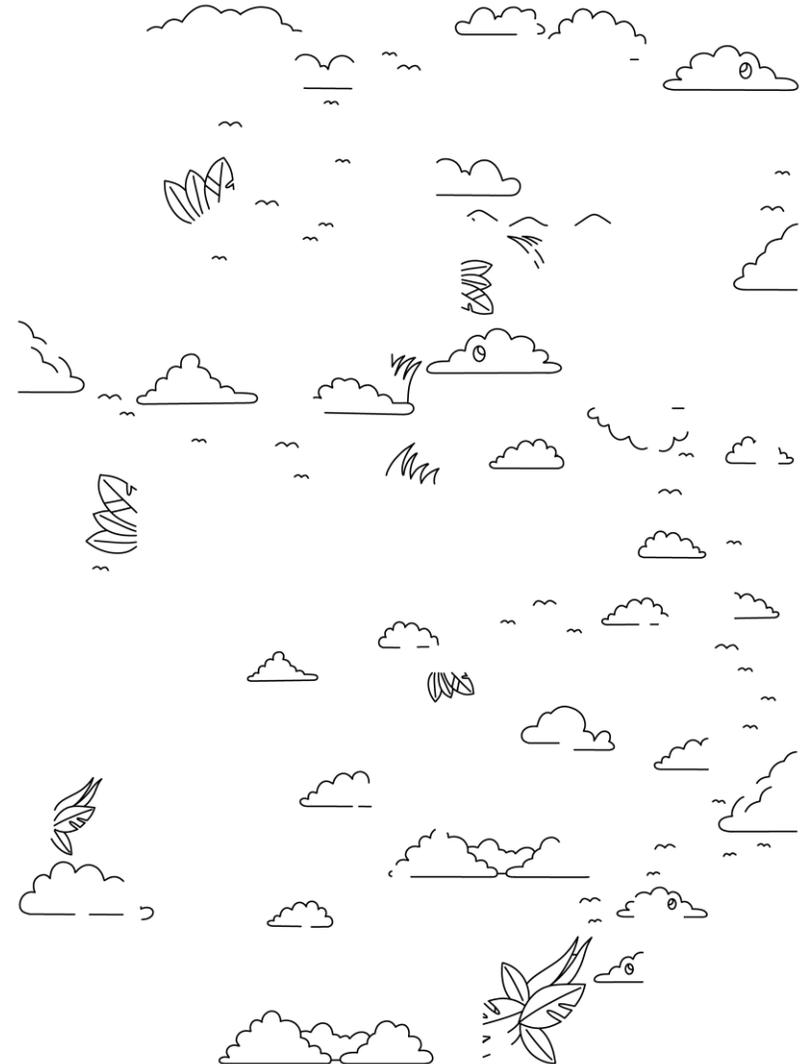
CLASSES: 3, 6, 14, 18, 35 (Perfumes; Jewellery; Metal storage containers for perfumes)

Trademarks - types

- Motion marks

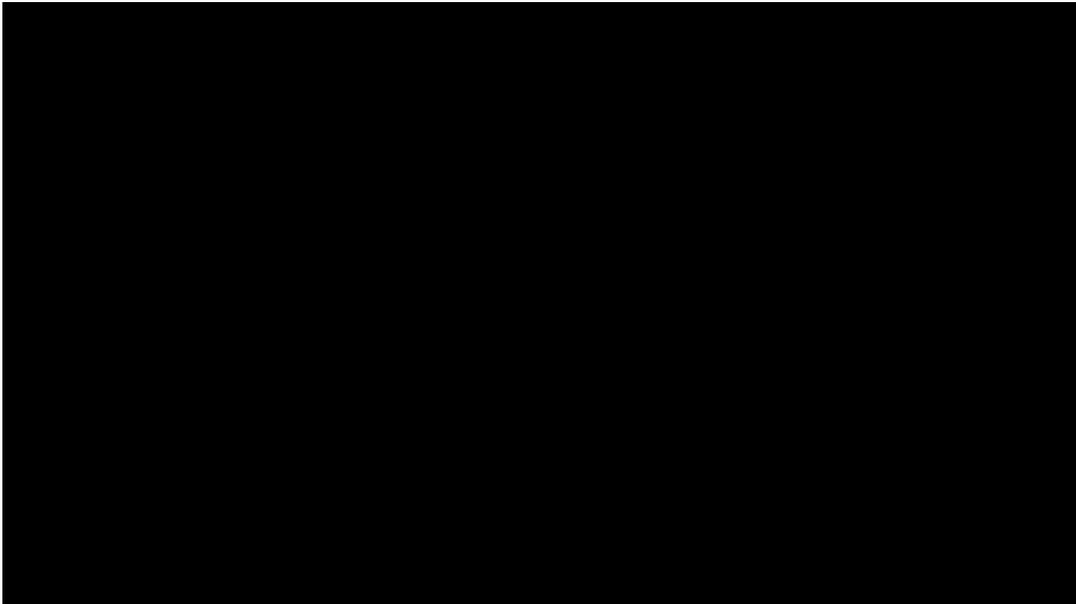
EUTM 018385621, Calzados Hergar, S.A.

CLASSES: 25, 35 (Footwear; Online retailing services of footwear and footwear parts)



Trademarks – types

- Motion marks



EXAMPLES OF ACCEPTABLE REPRESENTATIONS FOR MOTION MARKS FROM CP11

Trademarks - types

- Motion marks – refusal to register
- Refusal to register a mark depicting a stream of water coming out of a tap.
- Class of goods/services: 11 (fittings for bathrooms, mixer taps, sink sprayers, showers etc.).
- Grounds for refusal: **the mark will not be perceived as an indication of the commercial origin of goods.**
- Applicant: Altered Stockholm AB (018254994).



Trademarks - types

- Sound marks



EUTM 018390531, SAMSUNG ELECTRONICS CO., LTD.

CLASSES: 7, 9, 10, 11 (Robotic vacuum cleaners; LED lamps;
cameras)

Trademarks – types

- Sound marks – refusal to register
- Refusal to register engine sound as a trademark.
- Class of goods/services: 12 (scooters).
- Grounds for refusal: **the mark will not be perceived as an indication of the commercial origin of goods.**
- Applicant: PIAGGIO & C. S.P.A. (EUTM 017889555).



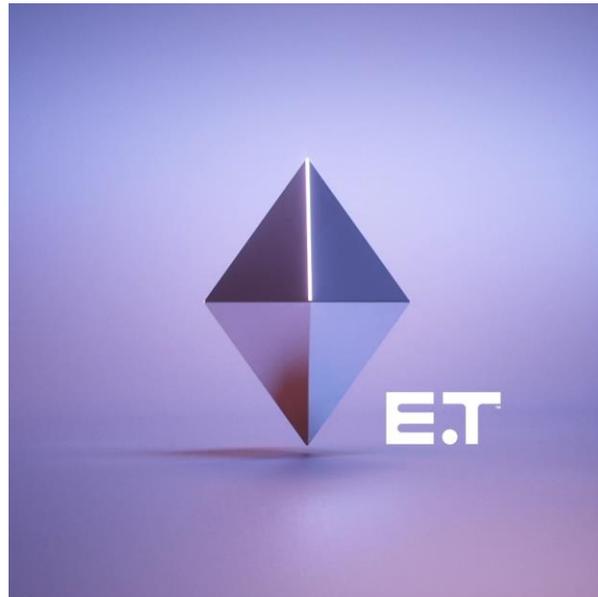
Trademarks – types

- Sound marks – refusal to register
- Refusal to register a 39-second melody as a trademark.
- Class of goods/services: 9, 38 (television broadcasting service).
- Grounds for refusal: **mark too long and complicated.**
- Applicant: NOWO COMMUNICATIONS, S.A. (017277864).



Trademarks - types

- Multimedia marks



EUTM 018502040, RENAULT s.a.s.

CLASS: 12 (Vehicles, ground locomotion equipment, automobiles, their components, i.e. suspension shock absorbers for vehicles)

Trademarks - types

- Multimedia marks



EUTM 018256498, C. & A. Veltins GmbH & Co. KG

CLASSES: 32, 33, 35 (Beer; Alcoholic beverages; Advertising, marketing and promotional services)

Trademarks – types

- Multimedia marks – refusal to register
- Refusal to register a pulsating multimedia mark (change of size, text and colour).
- Class of goods/services: 9, 36, 38, 41, 42 (data processing equipment and computers, banking and financing services etc.).
- Grounds for refusal: **consumers will not perceive the usual sequence of consecutive values as an indication of the commercial origin of goods and services.**
- Applicant: Wintrado Technologie AG (017889338).



-5.00€

Trademark types

- Shape marks



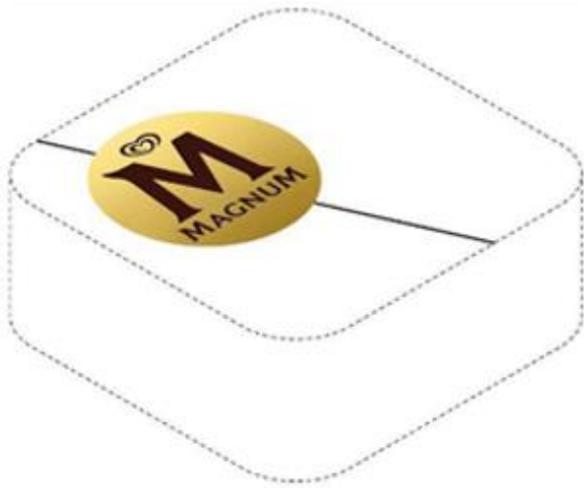
R.352722



EUTM 018825789

Trademark types

- Position marks



EUTM 018825835



EUTM 018172864



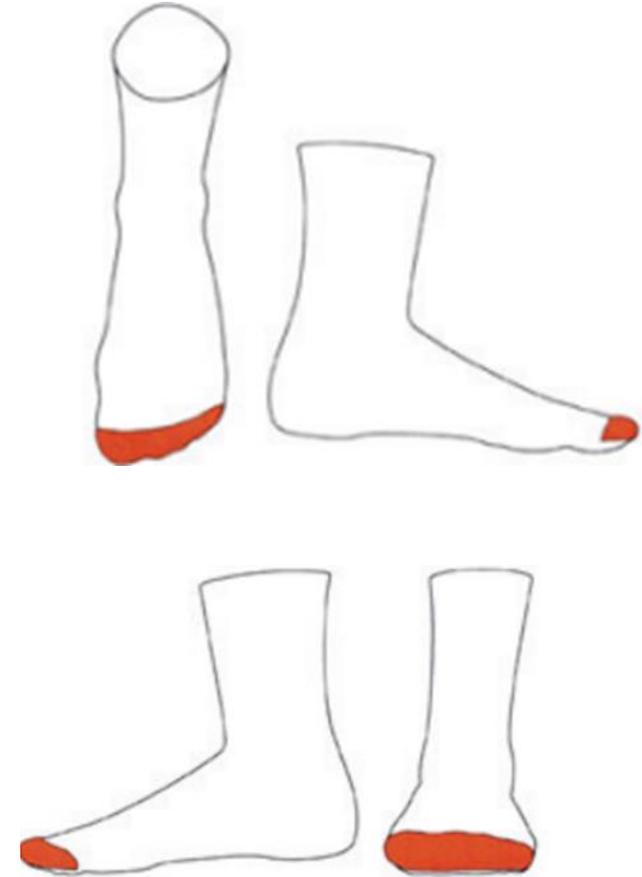
R.323023

Trademarks types

- Position marks – refusal to register

It was found that the colouring of the toe of the sock would be perceived as **decorative or functional** to reinforce the toes, and thus was not distinctive within the sock industry.

*Court judgment (Second Chamber) of 15 June 2010, T-547/08

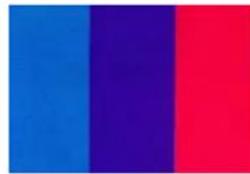


Trademark types

- Colour marks



EUTM No 31 336



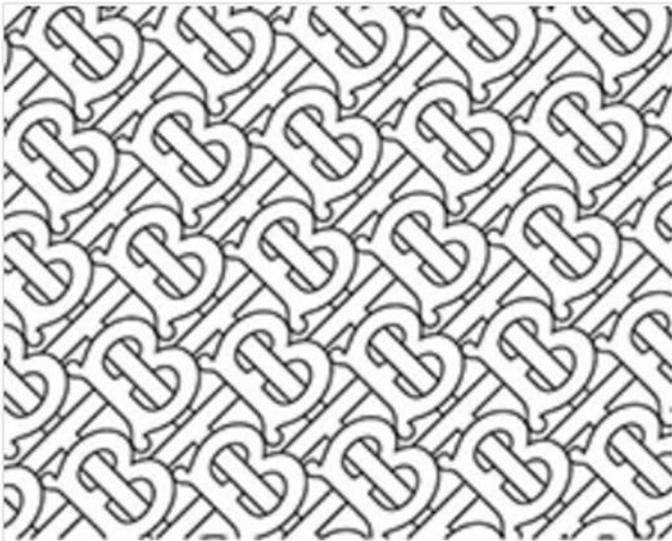
EUTM No 2 467 876



EUTM 3 286 614

Trademark types

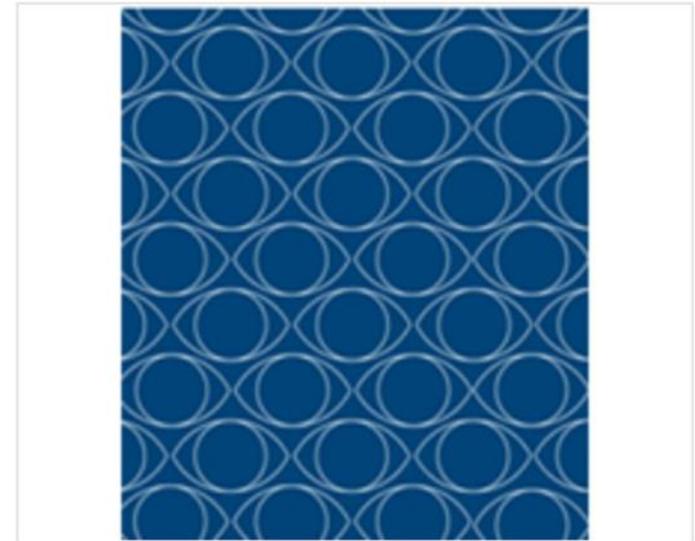
- Pattern marks



ZTUE 017993008



ZTUE 000015602

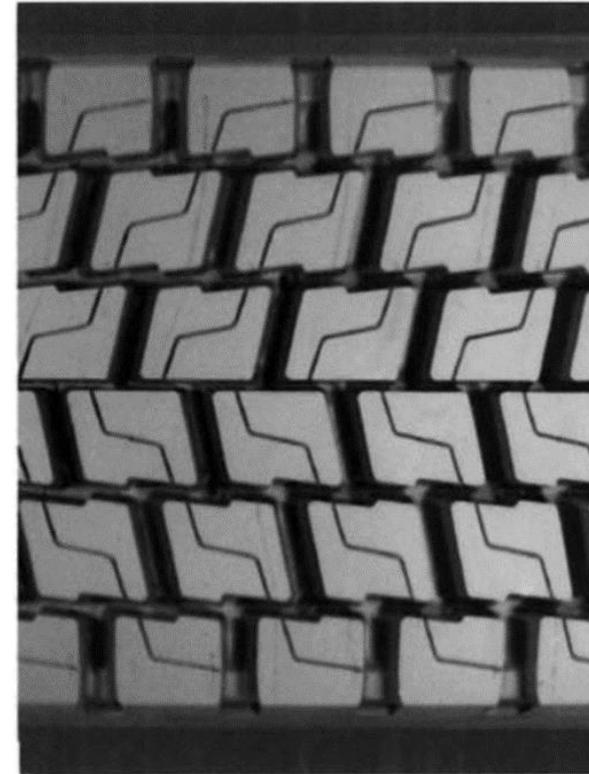


ZTUE 005365754

Trademark types

- Pattern marks – refusal to register

In this case of an application for tires, the relevant consumer would perceive the mark as merely a representation of the grooves of a tire, and not an indication of source of origin.



EUTM 005066535

Trademark types

- Smell/olfactory or taste marks are currently **not acceptable**. This is because the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Current state of technology and science does not allow these types of marks to be represented in such way.
- The EUTMIR does not recognize the submission of samples or specimens as suitable representation. A mark description cannot replace the representation, because a description of a smell or taste is neither clear, precise nor objective.
- Therefore, any application for an olfactory or taste mark will not be treated as an application for an EUTM ('deemed not filed') by the Office since it would not comply with the requirements for obtaining a filing date.

Example



EUTM 01122118

Mark description: Smell of ripe strawberries

27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34

The Court considered that the smell of strawberries varies from one variety to another, and the description „smell of ripe strawberries” can refer to several varieties and therefore to several distinct smells. The description was found neither unequivocal nor precise and did not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed.

Trademarks

Practical tips



Trademarks – practical tips

- **After you have successfully registered a trademark...**
 - You can show that the trademark is protected (by using the symbols ® - trademark registered with the Polish Patent Office or ™). This may deter potential infringers from illegal activities. Please note that you cannot use these symbols before registering your trademark.
 - You have to **start using the trademark** within the specified period!

Trademarks – practical tips

- Trademarks are **vulnerable to cancellation** if they are not used within five years from the date of registration (EUIPO, UK) or from the date of application for registration (Polish Patent Office).
- The use of a trademark consists in particular of:
 - affixing that mark to the protected goods or their packaging,
 - importing or exporting them and storing them for the purpose of offering and putting them on the market,
 - affixing the mark to documents related to the placing on the market of goods or the providing of services,
 - using it for advertising purposes.

Trademarks – practical tips

- Once you obtain a trademark **commence its regular monitoring** by verifying new applications in the registers!
- The office **will not block** the registration of a mark identical or similar to your trademark of its own initiative. Regular browsing of the registers and consistent filing of oppositions is necessary.
- Before the Polish Patent Office, the opposition period is 3 months from the date of publication of the application for the contested trademark in the Office Bulletin. At the EUIPO, opposition can be filed within 3 months of the publication of the EU trademark application.

Trademarks – practical tips



A trademark is subject to "genuine use" when it is used in accordance with its essential function, which is to guarantee the origin of the goods and services for which it is registered, so as to create or preserve a market for those goods and services. In contrast, it does not include cases of use of a symbolic nature, aimed merely at maintaining the rights to the trademark.



The mere presence of a trademark on a website is not sufficient to prove genuine use, unless the website also indicates the place, time and extent of use or such information is provided in other ways (e.g. with other evidence - invoices, proof of order). The evidence provided must show a link between the online transactions and the goods bearing the mark.

Trademark – other pitfalls

 **EUIPO - European Union Intellectual Pr...**
114 937 obserwujących
3 h · Edytowano · 

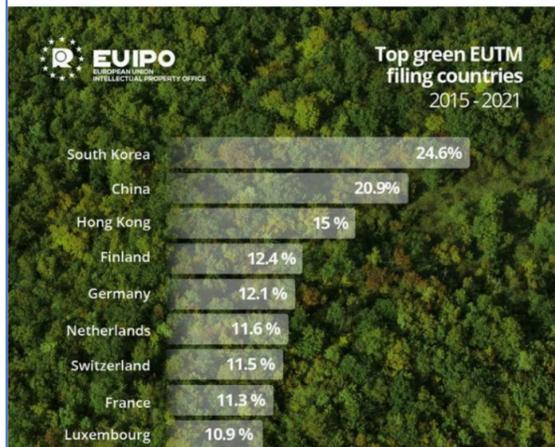
Are EU trade marks going green? As companies become more eco-friendly, the demand to protect sustainable innovations is on the rise.

According to EUIPO data, the number of EU trade mark applications containing terms associated with environmental protection has gone from 1,600 in 1996 to almost 19,000 in 2021. Today, they account for 12 % of all filings.

Learn more findings: <https://lnkd.in/drauqgJZ>

[#trademarks](#) [#greentrademarks](#) [#intellectualproperty](#)
[#climatechange](#) [#EUGreenDeal](#)

[Zobacz tłumaczenie](#)



- Even when there are no grounds for refusal judging by the trademark regulations, there can be other reasons why using certain trademarks may pose and generate risks
- This is now especially apparent when it comes to „green trademarks” that include environmental claims in word („green”, „eco”, „responsible” etc.) or symbolic form (leaves, water savings, CO₂ reduction).

Trademarks – term of protection

- Trademark protection lasts **10 years**. This time is calculated from the date of filing the trademark application at the Patent Office. The trademark right may be renewed for further 10 years (and so on), provided the fee is paid on time.
- The nice classification is a standardised list of classes of goods and services in which one can apply for a trade mark (classes 1-45). It serves as a helpful instrument but it is not mandatory to use its terms.

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AKCYJNA
R.349829



Class 30: Confectionery; Gingerbread; Pastry

Trademarks – practical information

- Fees and payments – EUIPO (filing an application)

Online registration	850€
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Second class	50€
--------------	-----

3 classes or more	150€
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Paper registration	1000€
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Second class	50€
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3 classes or more	150€
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Trademarks – practical information

- Fees and payments – EUIPO (renewal – rules parallel to filing)
- Online renewal costs €850 for one class. The fee for renewing on paper is €1 000. €50 for the second class and €150 for the third and above.
- If you didn't meet the required deadline but still want to renew your trademark, you can do so up to 6 months after the expiry date, but there is a **25% surcharge**.

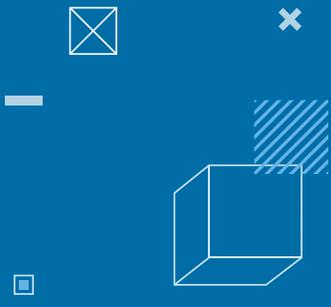
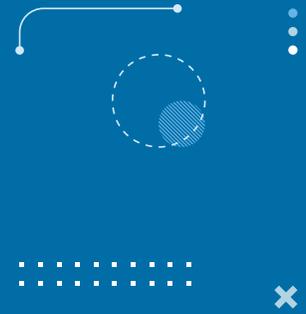
Trademarks – key takeaways

- 1) Pre-application trademark examination
- 2) Specialisation principle
- 3) Friction between territoriality and being a global brand
- 4) A range of mark types to choose from
- 5) Requirement of trademark use
- 6) Monitoring of the market and competitors' activities – immediate reaction!

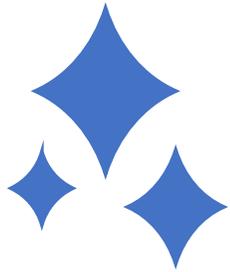


Part V

Patents



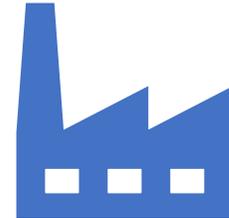
Patents – fundamentals



novelty



inventive step



suitable for industrial
application

A patent is valid for **twenty years** from the date of filing the patent application with the Patent Office.

Patents – novelty

- An invention is considered new if it is not part of the „state of the art”.
- The state of the art is understood as everything that, before the date according to which priority to obtain a patent is determined, has been made available to the public in the form of a written or oral description, by use, exhibition or disclosure in any other way.
- In order to assess whether a solution is new, it is the mere fact of making available (disclosure) that is important, and not whether anyone has become acquainted with the invention made available.
- The disclosure of an invention is considered to be such a presentation of its essence that an expert in the field to which the invention relates may have the possibility to realize it.

Patents - inventive step



The assessment of the inventive step should be carried out from the point of view of an expert in the field of technology to which the invention belongs, taking into account similar solutions known at the priority date and having general technical knowledge.

Patents – suitability for industrial application

- An invention is considered to be industrially applicable if, according to the invention, a product can be obtained or a process used, in the technical sense, in any industrial activity, not excluding agriculture.
- An applicable invention exists when it can be applied (realized) in a reproducible manner with identical effect.
- Such an invention must contain all the technical means possible for its application and must be capable of being used. It must realize some concrete objective of practical importance, satisfy some practical need.

Patents

Protection is sought for inventions in product or method categories.

We can divide inventions into:

- **structural**, relating to the shape, construction or assembly of an object with a permanent form;
- **substances**, e.g. drugs or chemicals;
- **technological**, involving the determination of a course of action, e.g. a method of manufacture or a method of storage;
- **biotechnological**, which are solutions concerning a product consisting of or containing biological material or the means by which biological material is produced, processed or used.

Patents v. esthetic nature



creations of a purely aesthetic nature cannot be an invention

A solution defined solely by one or more aesthetic features (e.g. color, surface pattern, decorative shape of a part or the entire product, sound sequence, smell) is considered a technical solution if at least one of these features allows achieving a technical effect.

For example, painting the blades of a fan black on one side and white on the other will cause a technical effect in the form of rotation of the blades of the fan after it is closed in a vacuum bubble and exposed to light. However, painting the entire blades in one color will not enable the fan to rotate - there will be no technical effect.

Patents - territory

- If protection is only needed in one European country, it is possible to register a patent at **national level**.
- To provide protection throughout Europe, a European patent can be registered with the **European Patent Office** (EPO). However, a European patent must be approved by the national patent office in each country where it is to provide protection. Depending on the law of the country in question, it may be necessary to submit a translation or pay fees by a specific deadline.
- Protection at the international level, requires referral to the **World Intellectual Property Organization** (WIPO).

Patents – description

The description of the invention should include the following parts:

- the title of the invention,
- definition of the field of technology,
- description of the state of the art,
- indication of the technical problem to be solved,
- disclosure of the invention,
- indication of possible beneficial effects of the invention,
- explanation of the figures of the drawing,
- example of implementation or application of the invention,
- indication of the industrial applicability of the invention.

Patents – significance of claims



The scope of the patent (what is protected) is determined by the patent claims contained in the patent description



A patent for an invention relating to a manufacturing method also covers products obtained directly by this method. A patent for an invention relating to the use of a substance which is part of the state of the art to obtain a product having a new use also covers products specially prepared in accordance with the invention for such use.

Patents – significance of claims



A patent for a biological material having the characteristics specified in the patent claim or claims as a result of the invention covers any biological material obtained from a given biological material by reproduction in an identical or different form and having the same characteristics.

Patents – significance of claims



A patent for a method that enables the production of biological material having the characteristics specified in the patent claim or claims as a result of the invention also covers biological material obtained directly by this method and any other biological material derived from biological material obtained directly by reproduction in an identical or different form and having the same characteristics.

Patents – significance of claims



A patent for a product containing or having genetic information covers all materials into which the product has been incorporated and in which genetic information fulfilling its function in this material has been included.

Patents – theory of equivalents

- The role of patent claims is that they serve not only to identify the subject matter of the patent (invention), but also to delimit the scope of protection resulting from the grant of a patent for such invention.
- Equivalent to the solution covered by the patent claims is a solution in which a technical means specified in the patent claims has been replaced by another but producing the same (intended) effect as the solution claimed, where, for the average expert, the use of this other (equivalent) means does not require any creative input, as it is in fact an implementation of the idea contained in the patent claims.
- Under the theory of equivalents, even though the solution opposed to the patented one differs from it (from its features indicated in the patent claims), it is considered patentable. The patent policies of various countries indicate a continuing diversity of views on the protection of equivalents.
- Poland: an expansive interpretation of patent claims resulting from the theory of equivalents is permissible. Its application is within the competence of the court deciding the patent dispute.

What is excluded from patenting?



Patents shall not be granted for methods of treating humans and animals with surgical or therapeutic methods and diagnostic methods applied to humans or animals. This provision applies only to methods of affecting living organisms of humans or animals by surgery or therapy, and to diagnostic methods used on these organisms.



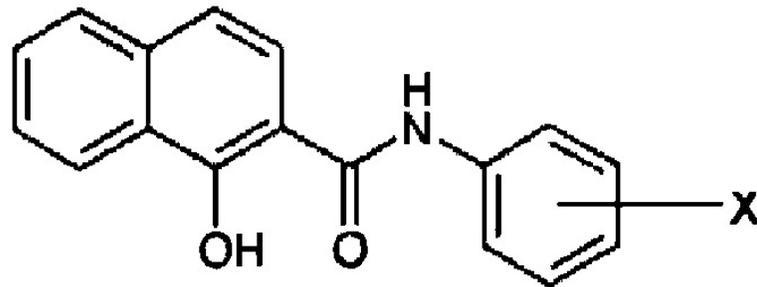
The prohibition on patenting also covers methods of treating humans and animals using surgical or therapeutic methods, even if they are carried out using a computer. Therefore, if the subject of the claim concerns a surgical or therapeutic method of influencing humans or animals that is excluded from patenting, an analogous computer-implemented method will also be excluded.

Disclosure and endorsement of inventions

- It is the applicant's responsibility to ensure that the invention is sufficiently disclosed at the filing date.
- In the case of new chemical compounds, the description of the application should include relevant data confirming that the claimed new compounds have been obtained and characterized, and that their utility properties related to the intended application have been tested.
- It is required to provide in the description of the invention the method of obtaining these compounds and the data identifying them, such as: melting and/or boiling point, spectral analysis.
- In addition, the applicant should indicate in the description of the invention what is the use of the claimed compounds. The determination of potential utility, deduced from the state of the art, is not a solution to a particular technical problem and sufficient disclosure.

Patents - examples

The subject of the invention are naphthalene derivatives based on the structure of o-hydroxynaphthalenic acid that can be used in the production of anti-cancer drugs.



wzór 1

Pat.236403, New derivatives of naphthalene and their application, UNIWERSYTET ŚLĄSKI

Patents - examples

- Oli-Tec has developed smart labels with time and temperature indicators that provide accurate shelf life monitoring of fresh, packaged or frozen products.
- The label indicates how many days the product has left to be consumed.
- It can be used on bottles (including glass), cardboard packaging and even plastic bags.
- The product aims to encourage safe, timely and economical food storage and consumption, helping to reduce waste.

WO 2018/011565

PCT/GB2017/052033

FIGURE 1

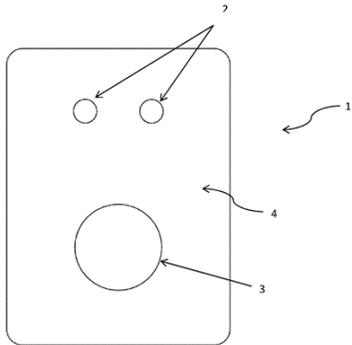
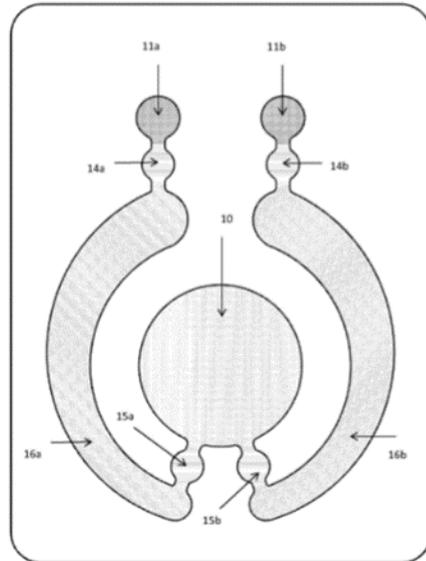
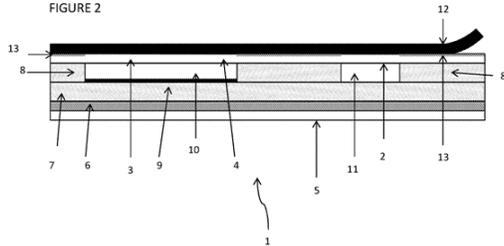


FIGURE 2



Patents - examples



- Polish company NapiFeryn BioTech has developed a way to extract proteins from rapeseed oil production waste to produce functional, nutritious and economical isolates and concentrates.
- According to experts, these ingredients are a promising alternative to animal proteins (among other things, due to their high nutritional content).
- The company is developing the know-how, which it plans to license to oil mills, for example.
- The raw material that would be produced there could be used to produce pasta, sweets or meat substitutes.
- The subject of the patent application is a method for obtaining a protein isolate, a protein isolate and its use for food purposes.

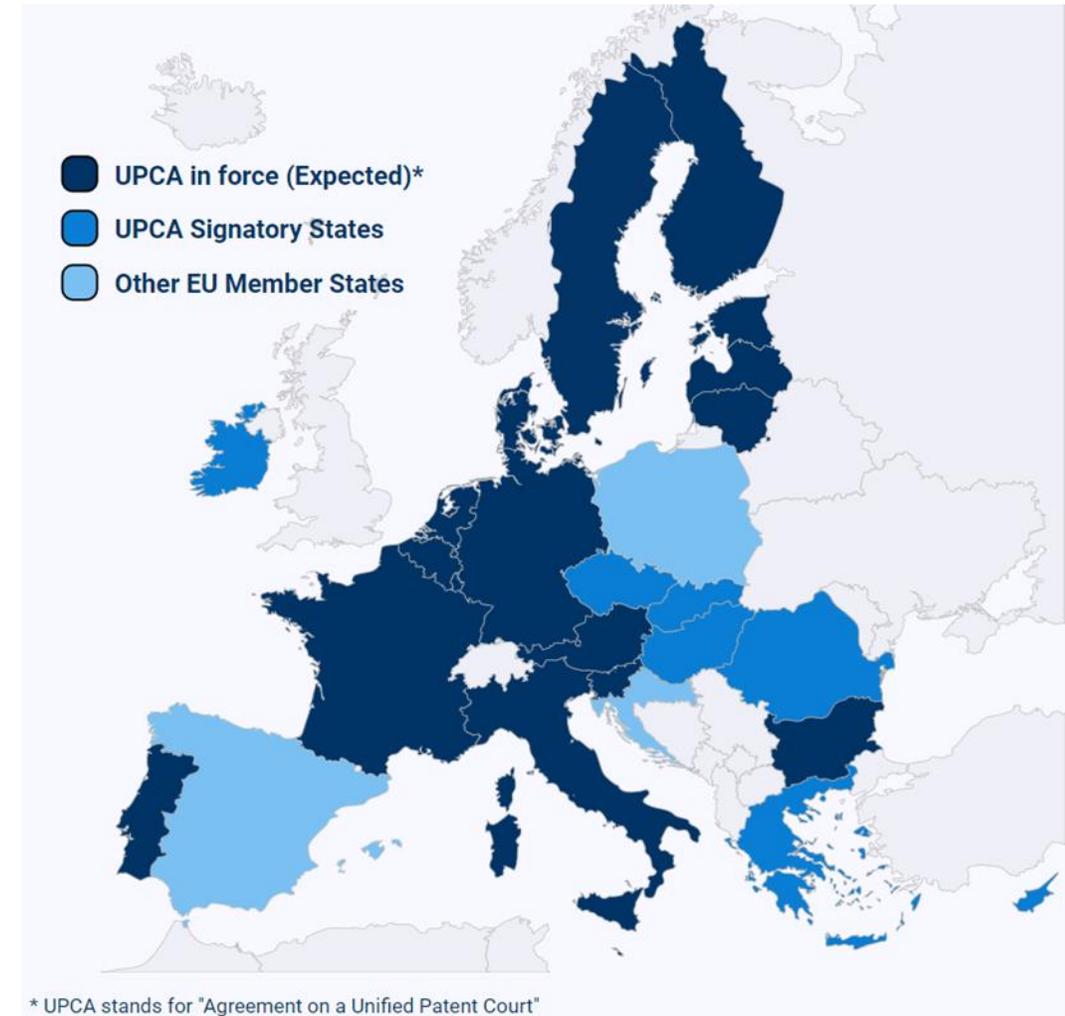
The Unified Patent Court

The Unified Patent Court (UPC) is a Court, comprising judges from all participating Member States of the European Union. It is set up to decide in particular on the infringement and validity of both Unitary Patents and classic European Patents. Poland decided not to join the system and not to ratify the UPC. The decision to stay out of the unitary patent system was motivated by concerns about its economic impact.

An entrepreneur who obtains a unitary patent will enjoy protection in all countries that participate in the system. Obtaining protection in Poland is only possible by:

- either filing a patent application with the Polish Patent Office, or
- validating a European patent.

Suits for infringement or invalidation of the patent would fall under the jurisdiction of Polish courts, not the UPC.



Unitary patent

- Before a Unitary Patent can be registered by the EPO, the applicant must first obtain a European patent. A European patent application must therefore be filed and processed under the EPC.
- Once a European patent has been granted, the proprietor must file a "request for unitary effect" at the EPO to obtain a Unitary Patent. The request must be filed within one month of the date of publication of the mention of the grant in the European Patent Bulletin.
- To be eligible for registration as a Unitary Patent, the European patent must have been granted with the same set of claims in respect of all the 25 Member States participating in enhanced co-operation.

Fees and payments – Polish Patent Office (for filing)

- **For filing an invention** – PLN 550
- for each page, over 20 pages of description , claims and drawings – PLN 25
- **For filing an invention in electronic form** – PLN 500
- for each page, over 20 pages of description , claims and drawings - PLN 25

Fees and payments – Polish Patent Office (protection)

Title of fee (inventions)	Amount of the fee in PLN
for the first period of protection (1st, 2nd and 3rd year of protection)	480.00
for the 4th year of protection	250.00
for the 5th year of protection	300.00
for the 6th year of protection	350.00
for the 7th year of protection	400.00
for the 8th year of protection	450.00
for the 9th year of protection	550.00
for the 10th year of protection	650.00
for the 11th year of protection	750.00
for the 12th year of protection	800.00
for the 13th year of protection	900.00
for the 14th year of protection	950.00
for the 15th year of protection	1050.00
for the 16th year of protection	1150.00
for the 17th year of protection	1250.00
for the 18th year of protection	1350.00
for the 19th year of protection	1450.00
for the 20th year of protection	1550.00

Patents – key takeaways

- Highly complex and demanding (by far the most difficult area of IP law)
- Whenever the possibility arises that an invention may be developed, it is crucial not to reveal it without first consulting with a patent attorney (for this category of rights the consequences of allowing public access to the protected good/item are especially dire)

Design protection

According to the definition an industrial design is a new appearance of a product or part thereof of individual character resulting from the features of, in particular, the lines, contours, shape, colours, texture and/or materials of the product itself and/or its ornamentation. A product is any industrial or artisan item, including in particular packaging, graphic symbols and typographic typefaces, but excluding computer programs.

An industrial design is considered new if no identical design has been made available to the public by being used, exhibited or otherwise, before the date according to which priority to obtain a right in registration is determined. A design is considered to be identical to a design made available to the public if their features differ only in immaterial details.

Examples



Packaging of products
RCD 002710731-0001



A product / set of
products
RCD 002490193-0001



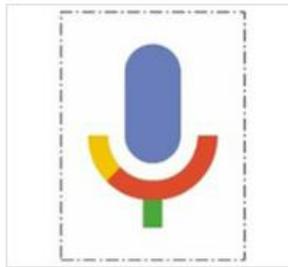
Composite products
RCD 000408166-0001



Parts of products
RCD 229752-0001



Logos
RCD 000754098-0001



Computer icons
RCD 003001494-0002



Typefaces
RCD 004007441-0016



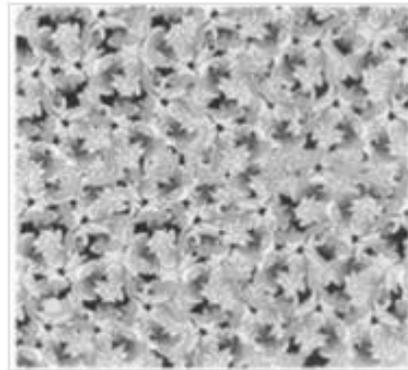
Graphic designs
RCD 004547370-0002

Examples



Get-ups

RCD 002213793-0001



Ornamentation

RCD 001446066-0009



Web design

RCD 003465632-0001



Maps

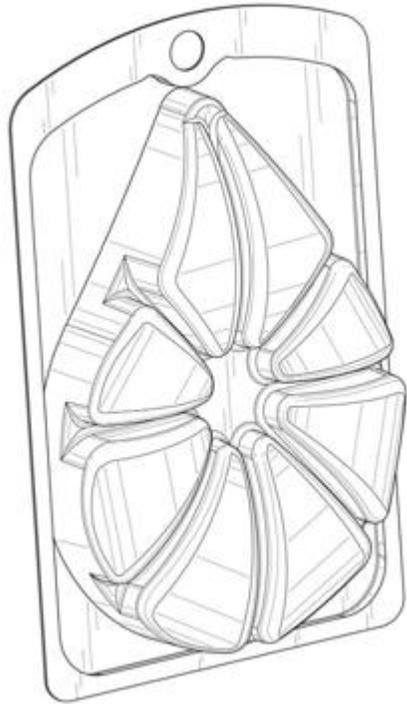
003567155-0001

Examples

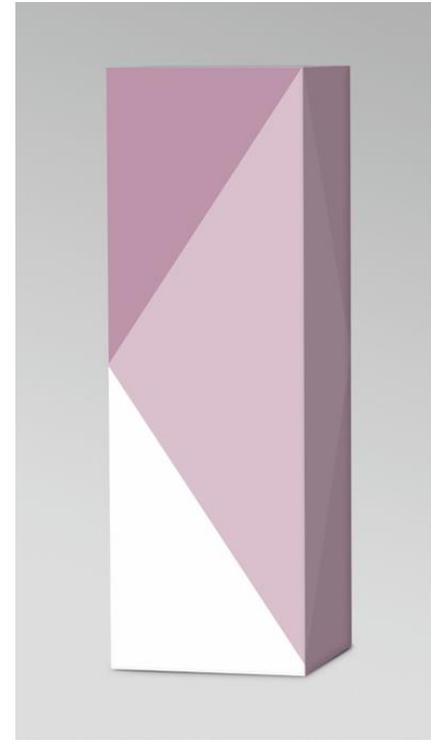
RCD No 2 325 456-0001



Examples

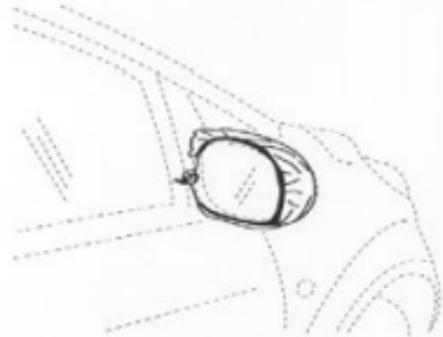
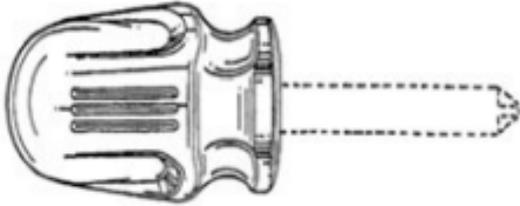


THE PROCTER & GAMBLE COMPANY, D095126



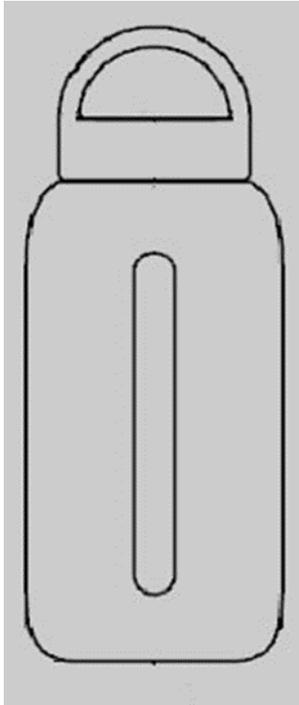
Ursapharm Arzneimittel GmbH, 015004688

Examples

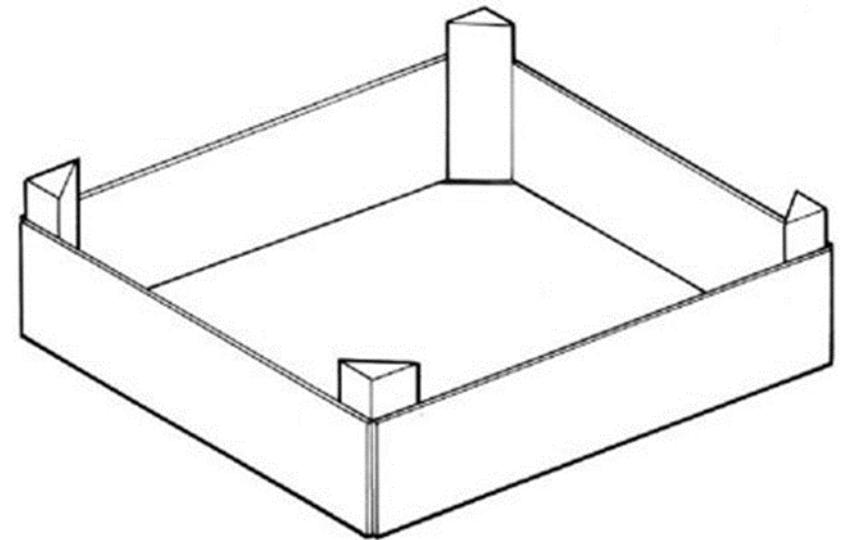
<p>RCD</p> <p>No 30 606-0005</p>	<p>Benelux design</p> <p>No 38212-0001</p>	<p>Hungarian design</p> <p>No D9900409-0001</p>
		

Design protection - cancellation

Impossibility of registering features of a product arising solely from its **technical function**.



MakeWithLove, application number 008624936, **design cancelled**



DOÑANA 1998, S.L., application no.
002235689, **design cancelled**

When to apply for an industrial design registration?

Request for deferment - when filing a Community design application, a request for deferment of publication for up to 30 months can be made. The design may therefore be treated as confidential until a decision on disclosure is taken (not more than 30 months).

Design protection – grace period

If you have disclosed your design and then decide that you want to apply for a design registration — either because you want full protection or for intellectual property strategy reasons – you can still do so **within 12 months of disclosure**.
This is known as the 'grace period'.

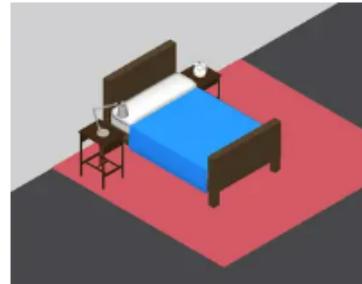
✓ **Acceptable**

Shows the design on a neutral background.



✗ **Unacceptable**

Shows the design with other elements on a non-neutral background.





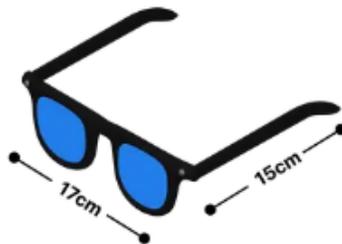
Acceptable

Contains only the design.



Unacceptable

Contains additional information and symbols.



Registered or unregistered protection?

There are two choices:

- either protect your design with the European Union Intellectual Property Office (EUIPO) or other Office before you commercialise it and obtain a registered design
- or, alternatively, commercialise it directly without registration by relying on what is known as the unregistered Community design (UCD) right.

Registered or unregistered protection?

Both offer the following protection:

- Manufacturing a product incorporating a protected design (or to which the design is applied) without the consent of its proprietor would be considered illegal.
- Putting a product on the market incorporating the protected design (or to which the design is applied) without the consent of its proprietor would be considered illegal.
- Offering a product for sale incorporating a protected design without the consent of its proprietor would be considered illegal.
- Marketing a product incorporating the protected design without the consent of its proprietor would be considered illegal.
- Importing/exporting a product incorporating the protected design without the consent of its proprietor would be considered illegal.

Registered or unregistered protection?

Differences in duration

- A registered design is initially valid for five years from the date of filing and can be renewed in blocks of five years up to a maximum of 25 years.
- An unregistered design is given protection for a period of three years from the date on which the design was first made available to the public within the territory of the European Union. After three years, the protection cannot be extended.

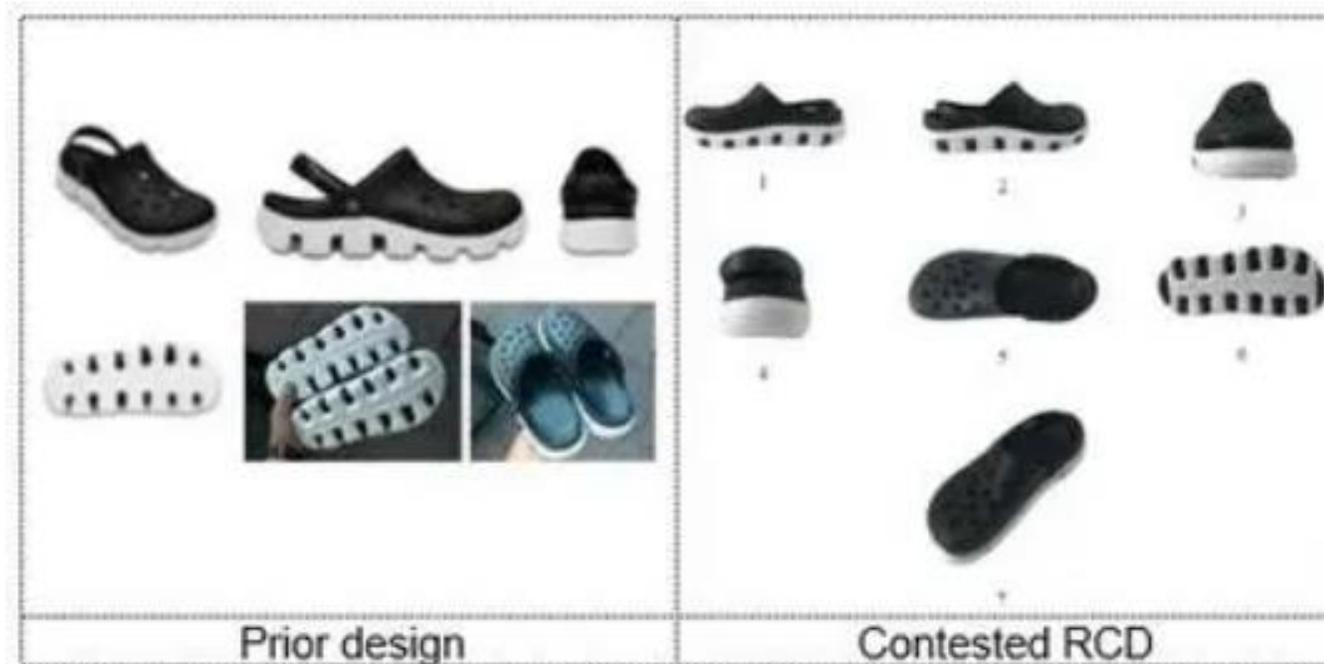
Registered or unregistered protection?

Differences in scope

- Registered Community designs are protected against similar designs even when the infringing design has been developed in good faith, i.e. without knowing of the existence of the earlier design.
- Unregistered Community designs grant the right to prevent commercial use of a design only if that design is an intentional copy of the protected one, made in bad faith, i.e. knowing of the existence of the earlier design.

The legal protection conferred by a registered design is stronger and more transparent.

Design producing the same overall impression as a Crocs' clog is invalidated



Ferrari vs. Mansory Design



Fees and payments – EUIPO (design registration)

- Registration fee - €230
- Fee for each design from the 2nd to the 10th design - €115
- Fee for each design from the 11th design onwards - €50
- Publication fee - €120. Fee for publication of each design from 2nd to the 10th design - €60. Fee for publication of each design from the 11th - €30.

Fees and payments – EUIPO (renewal)

Fee code	Description of the fee	Amount
D-041	Fee for the first period of renewal	€90
D-042	Fee for the second period of renewal	€120
D-043	Fee for the third period of renewal	€150
D-044	Fee for the fourth period of renewal	€180
D-045	Fee for the late payment of the renewal fee or the late submission of the request for renewal (Article 13(3) of Regulation (EC) No 6/2002; Article 22(2)(b) of Regulation (EC) No 2245/2002)	25% of the additional fees

Fees and payments – Polish Patent Office (design registration)

- For filing an industrial design – PLN 300
- For the publication on the granted right of registration – PLN 70
- The attorney's fee for the power of attorney should be added - PLN 17.

Fees and payments – Polish Patent Office (renewal)

Fee title	Amount of the fee in PLN
for the first period of protection (1st, 2nd, 3rd, 4th and 5th year of protection)	150.00
for the second protection period (6th, 7th, 8th, 9th and 10th year of protection)	250.00
for the third protection period (11th, 12th, 13th, 14th and 15th year of protection)	500.00
for the fourth period of protection (16th, 17th, 18th, 19th and 20th year of protection)	1000.00
for the fifth protection period (21st, 22nd, 23rd, 24th and 25th year of protection)	2000.00

Trade secrets

- Different approach and means of protection in many countries (sometimes understood as limited to *know-how* protection) – usually recognised as an unfair competition tort or civil law tort
- In 2016 a EU directive was passed to standardise and unify legal instruments in the area of trade secrets among member states in order to foster growth in the internal market and remove barriers to trade
- Some argue that the new system introduced a new type of IP right to trade secrets but many dispute such an evaluation...

Trade secrets

- Trade secrets protection differs in many ways from usual IP protection

IP protection	Trade secrets protection
Grants an exclusive right	Other persons may have access and use certain data, information or know-how if it was lawfully or independantly acquired or developed
Does not rely on the need to take any special action to benefit from protection	Requires the holder to take steps to keep it secret
Necessary in order to allow the owner to safely make the goods publicly available	Necessary in order to prevent the secret from becoming publicly known
Typically limited timewise	Lasts as long as the state of secrecy is upheld

Trade secrets

Is the Coca-Cola formula kept secret because the company has something to hide?

Yes, but in a good way.

The formula for making Coca-Cola is a trade secret. We have protected the special taste of Coca-Cola for more than 130 years. Only The Coca-Cola Company knows how to make Coca-Cola. That way, when you buy one of our drinks, you can be sure you're getting the same delicious and refreshing experience time and time again!

Did you know? The most closely guarded and best-kept secret in the food and drinks industry, the Coca-Cola formula is a complex blend of natural flavours. Although it has been frequently imitated, it has never been replicated.

Trade secrets

- How to defend if someone accuses you of stealing or misappropriating their trade secrets?
- Prove that the data, information or knowledge of other kind:
 - was independently discovered or created;
 - was obtained through observation, disassembly or testing while you were not under any contractual obligation to not acquire the trade secret;
 - was acquired through a practice which is in conformity with honest commercial practices;
 - was acquired, used or disclosed due to obligations under EU or national law.

Trade secrets



- To avoid potential disputes regarding third parties' trade secrets, make sure to indicate on your internal materials that they contain such data.
- Consider also additional organisational solutions and steps to keep in check who has access to such information, what purposes they can use it for and under what circumstances (e.g. authorisation by a supervisor may be required).
- You may require that files with such data contain a certain abbreviation in their name, that they require a password to open, that they can only be stored on a secure server etc.

Trade secrets

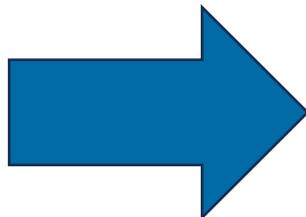
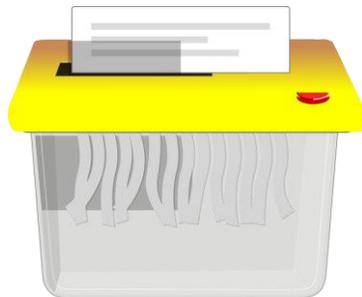
- The same basic principles apply when it comes to your own trade secrets.
- It is worth noting that in this case internal regulations such as trade secrets' protection policy, play an even bigger role, since it will probably be much more common for your employees to come in contact with information that your business qualifies as confidential.
- Such a regulation could for example present different categories of confidential data and various requirements that apply when handling it, depending i.a. on factors such as one's position, intended use, the data's time-sensitivity and so on.



Trade secrets

- For compliance and evidentiary reasons it is advised to require that employees sign a declaration that they have read through, understood and undertake to uphold the rules of handling confidential information.

Careful! *In order to avoid having such rules questioned at a later date (including whether they have been appropriately communicated to the crew/staff), the employees should be given enough time to carefully read through presented materials. Regular reminders, such as mandatory trainings or tests, are also advisable.*



Trade secrets

- Restricting access to trade secrets is essential for their protection to function properly and effectively.

Careful! *When sharing trade secrets with third parties there is a tendency to generalise and simply state that all the information provided to the other party constitutes a trade secret and should be treated as such – without imposing any real obligations on the other party to take specific measures to protect such data and without sanctions for failure to do so. A general confidentiality clause is often not enough.*

Special attention should also be paid to provisions regarding the consequences for shared data after the contract has expired or has been terminated.

Trade secrets

- What can you protect yourself from?
 - Unlawful acquisition of a trade secret (without your consent), especially through obtaining unauthorised access.
 - Use or disclosure of a trade secret
 - after it has been acquired unlawfully,
 - contrary to contractual terms binding on the party in question.

Trade secrets

- What can you protect yourself from?
 - Acquisition, use or disclosure of a trade secret – if the party knew or ought to have known that the trade secret was revealed to that party in breach or as an effect of a breach of the rules specified above.
 - Production, offering, sale, import, export or storage of „infringing products” that is products regarding which one ought to have known that they were created in breach or as an effect of a breach of the aforementioned rules.

Part VII

Other intellectual property...



What else is there?

- Geographical indications and designations of origin

Kołocz śląski / kołacz śląski



Country/ies of origin Poland	Type Protected Geographical Indication (PGI)		
Priority date 20/11/2008	File number PGI-PL-0728	Product type Food	Basis of protection EU register
Status Registered	Product category Class 2.3. Bread, pastry, cakes, confectionery, biscuits and other baker's wares		

Legal instrument of protection at EU level

Official Journal L 195, 27.07.2011

Publications

Official Journal C 299, 05.11.2010

Official Journal L 195, 27.07.2011

Protections under international agreements

Country authorities

 **Ministerstwo Rolnictwa i Rozwoju Wsi**

ul. Wspólna 30
00-930 Warszawa
Poland

<https://www.gov.pl/web/rolnictwo/produkty-regionalne-i-tradycyjne1>

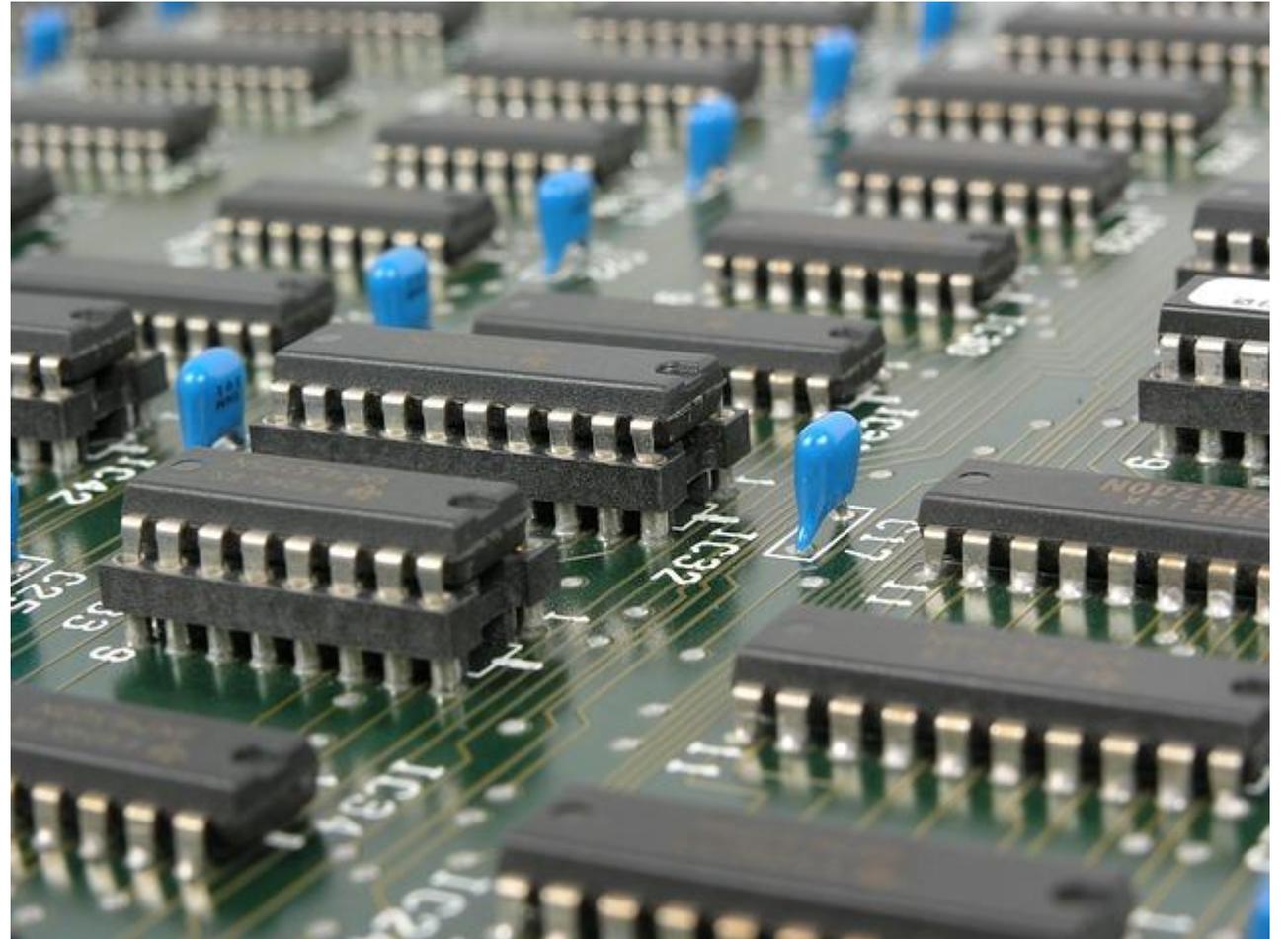
What else is there?

- Plant variety

General				
Application number:	20060082	Status:	Granted i	
Application date:	14/02/2006	UPOV Code:	RIBES_NIG	
Species:	Ribes nigrum L.			
First sale inside EU:		Country:	i	
First sale outside EU:		Country:	i	
Application				
Arrival date:	04/01/2006	National application date:		
Crop sector:	Fruit			
Denomination:	Tines			
Breeder's reference:	pc-106			
Title				
Title number:	19038			
Title date:	22/01/2007	Expiration date of protection:	31/12/2035	
Parties				
Role	Code	Name	Official address	Mail address
Applicant	07220	Institut Ogrodnictwa - Państwowy Instytut Badawczy (The National Institute of Horticultural Research)	Institut Ogrodnictwa - Państwowy Instytut Badawczy (The National Institute of Horticultural Research) ul. Konstytucji 3 Maja 1/3 PL - 96-100 Skierniewice POLAND	Institut Ogrodnictwa - Państwowy Instytut Badawczy (The National Institute of Horticultural Research) ul. Konstytucji 3 Maja 1/3 PL - 96-100 Skierniewice POLAND
Breeder	04811	Institut Sadownictwa i Kwiaciarstwa im. Szczepana Pieniazka	Institut Sadownictwa i Kwiaciarstwa im. Szczepana Pieniazka ul. Pomologiczna 18 PL - 96100 Skierniewice POLAND	Institut Sadownictwa i Kwiaciarstwa im. Szczepana Pieniazka ul. Pomologiczna 18 PL - 96100 Skierniewice POLAND

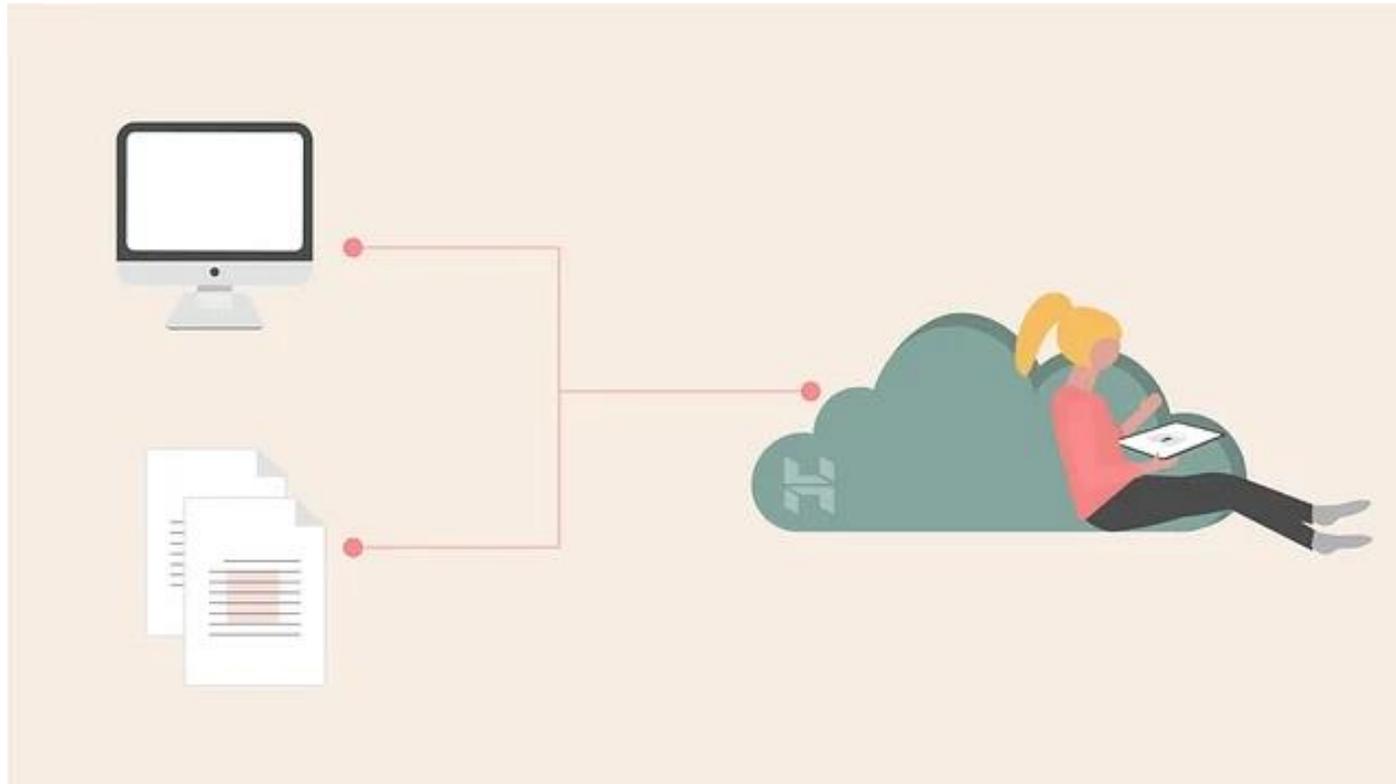
What else is there?

- Topography of integrated circuits



What else is there?

- Database protection

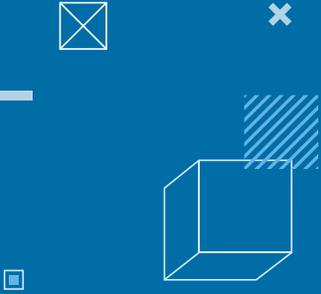
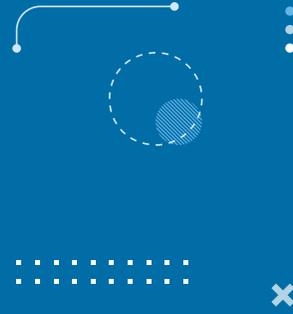


What else is there?

...AND EVEN MORE!

Opportunities

Benefit from IP promotion programmes



EU funding for SMEs

- Grants to **micro, small and medium-sized** entrepreneurs based in one of the EU Member States or in Ukraine at the time of application **for the registration of trademarks and industrial designs.**
- Funding can also apply to **applications for inventions and new plant varieties.**
- Entrepreneurs who have received a grant from the fund in previous years can also apply for funding!
- The grant may not be awarded retroactively, and the costs of activities carried out before the grant decision was issued cannot be reimbursed (one needs to apply for the grant before filing an application)!
- The fund runs until 6 December 2024 or until the funds are exhausted. The total funding available is limited and grants are awarded based on the order of applications.

EU funding for SMEs

- reimbursement of **75% of fees** at national level (Polish Patent Office), regional level (Benelux countries) and EU level (EUIPO)
 - for applying for a **trademark or industrial design**, and fees for adding classes, as well as registration, publication, and deferment
- reimbursement of **50% of fees** at the international level (WIPO)
 - for **trademark or industrial design application**, basic fees, for designation or subsequent designation. Designation fees for an international trademark or design in EU Member States or the EUIPO are considered eligible. Handling fees charged by the office of origin are excluded

EU funding for SMEs

Reimbursement of 75% of

- **fees for prior state of the art search** - fees charged by Member States' intellectual property offices for the provision of prior state of the art search services (including examination services provided by the Visegrad Patent Institute)
- **patent fees for national patent protection** - fees charged by Member States' intellectual property offices for the registration of national patents include the applicable fees for obtaining national patent protection in an EU Member State (i.e. application fees, processing and examination fees, grant and publication-related fees)
- **fees for European patent application** - fees, including both application and examination fees, charged by the European Patent Office (EPO) with respect to European patents. Patent applications filed under the Patent Cooperation Treaty are not eligible

Maximum reimbursement of up to EUR 1500 in fees.

EU funding for SMEs

50% refund of legal costs relating to the preparation and filing of a new European patent application.

Maximum EUR 2000 reimbursement of costs.

#EENCanHelp

Thank you

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een.ec.europa.eu



Traple
Konarski
Podrecki
& Wspólnicy



Krakow Chamber
of Commerce and Industry

